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Supreme Court of the United States

October Term, 1975
No. 75-1405

MARSHALL FIELD & CO.,
Petitioner,

vs.

MARIAN SHOUP,
Respondent.

PETITION FOR A WRIT OF CERTIORARI
To the United States Court of Appeals
For the Seventh Circuit

BRUCE B. KROST
WOODLING, KROST, GRANGER & RUST
655 Union Commerce Building
Cleveland, Ohio 44115

DALLETT HOOPES
c/o SCOVILL MANUFACTURING COMPANY
Scovill Square
Waterbury, Connecticut 06720

CLARENCE J. FLEMING
McDOUGALL, HERSH & SCOTT
135 S. LaSalle Street
Chicago, Illinois 60603
Counsel for Petitioner

THE GATES LEGAL PUBLISHING CO., CLEVELAND, OHIO—TEL. (216) 621-5647

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MARSHALL FIELD & CO.,
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MARIAN SHOUP,
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PETITION FOR A WRIT OF CERTIORARI
To the United States Court of Appeals
For the Seventh Circuit

To The Honorable, the Chief Justice and the Associate Justices of the Supreme Court of the United States:

Your Petitioner, Marshall Field & Co., respectfully prays that a Writ of Certiorari issue to review the judgment of the United States Circuit Court of Appeals for the Seventh Circuit entered March 1, 1976.

CITATIONS TO OPINIONS BELOW

The opinion and judgment of the Circuit Court for the Seventh Circuit is printed in Appendix A-1 and Appendix A-2, respectively, to this Petition. It will not be

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published by Curiam Order of the said Court of Appeals under the provisions of Rule 28 of the Seventh Circuit Court of Appeals.

The opinions and judgments of the United States District Court for the Northern District of Illinois, Eastern Division, affirmed by the Court of Appeals, consist of:

(a) The Memorandum Opinion And Order of the District Court dated October 15, 1974 ruling upon the issue of title to the patent subject of the action below. This Memorandum Opinion And Order was not published. It is printed in Appendix B to this Petition; and

(b) The Findings Of Fact, Conclusions Of Law And Judgment Order of the District Court dated June 4, 1975, ruling upon the issues of validity and infringement of the patent subject of the action below, and including the same finding on title to the patent. The Findings Of Fact, Conclusions Of Law And Judgment Order have not been published and are printed in Appendix C to this Petition; and

(c) Amended Judgment of the District Court dated June 16, 1975. This Amended Judgment was not published. It is printed in Appendix D to this Petition.

JURISDICTION

The judgment of the Circuit Court of Appeals was entered March 1, 1976.

The jurisdiction of this Court is invoked under 28 U.S.C. 1254(1).

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QUESTIONS PRESENTED

1. Has the Petitioner's established right to be sued for patent infringement only by the legal owner of the patent been abridged by awarding judgment to Respondent on the basis of a false notation of title erroneously printed on the patent through a mistake of a clerk in the Patent Office rather than on the basis of the written assignment instruments of record demonstrating that title to the patent is not in Respondent but resides in another not a party to the action?

2. Should Petitioner remain vulnerable to another action for patent infringement by the true legal owner of the patent whose title is shown by all the written assignment instruments of record at a later date after judgment for patent infringement has been granted below in favor of Respondent who is not truly the owner of the patent but who was only recognized by the courts below as entitled to sue as plaintiff solely on the basis of a false notation of title printed on the patent through a mistake of a clerk in the Patent Office?

3. Which should govern the courts in adjudging title to a patent, the written assignment instruments conveying title in the manner provided in the statute, 35 U.S.C. 261, *or* the notation printed on the patent when issued as to ownership of the patent, which notation was false through the mistake of a clerk in the Patent Office, the printing of any notation as to ownership not being required by statute?

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STATUTES INVOLVED

The statutory provisions involved and printed in Appendix E to this Petition are:

35 U.S.C. 261 providing that legal title to a patent or patent application is transferable by written assignment instrument, and further providing for recording in the Patent Office of such written assignment instruments within three months of the assignment for the protection of later, innocent purchasers for value, if any.

35 U.S.C. 152 providing that patents on issuance may be granted to the legal owner of the patent as such legal ownership is shown in written assignment instruments recorded in the Patent Office during pendency of the application and before issuance of the patent, if such instrument has been recorded before issuance.

35 U.S.C. 281 providing that patent infringement actions are to be brought by the patentee.

STATEMENT

United States patent No. 3,174,863, subject of the action below, was issued March 23, 1965 on an alleged invention of Allen A. Shoup, on a "Smokeless Broiler". A copy of this patent, based on a patent application filed February 13, 1961, appears as Appendix F in the separately bound volume filed as an Additional Appendix to this Petition.

According to the written assignment instruments of record below, full title to this Shoup patent now resides in the Shoup Engineering Corporation, a corporation of

Wisconsin. Insofar as disclosed in the record below, the Shoup Engineering Corporation is still in existence and owns the patent. Although not of record, it is possible that Shoup Engineering Corporation may have since assigned the Shoup patent to some unknown person or firm not a party to the action below.

Neither the Shoup Engineering Corporation, nor any unknown person or firm that might have since acquired the patent from the Shoup Engineering Corporation, was a party to the action below. The Petitioner remains vulnerable to an action for infringement of the Shoup patent that may be brought by the present legal owner of the patent, either the Shoup Engineering Corporation or some unknown person or firm who may since have acquired title from the Shoup Engineering Corporation.

Printed in the heading of the Shoup patent, Appendix F, when issued, is the notation:

> "Allen A. Shoup, Janesville, Wis., assignor by mesne assignments, to Irene Schneider Trust."

The printing of such a notation on the heading of a patent when issued is not required by any statute. Such a notation has been customarily printed, as being a possible convenience to the public, by clerical personnel in the Patent Office charged with the printing of patents.

The above notation printed in the heading of the Shoup patent is false. The Irene Schneider Trust, according to the written Assignment instruments of record below, was not the owner, and never was the owner, of legal title to the Shoup patent.

The Respondent claims to have derived her title to the patent from the Irene Schneider Trust. If the Irene Schneider Trust, when purporting to assign title to the

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Shoup patent to the Respondent, did not itself then possess title to the patent, then the Respondent received nothing and she now possesses no title whatever.

As only the holder of 100% legal title to a patent is entitled to maintain an action for infringement of the patent (citations below), the Respondent, who has never possessed legal title to the patent, was not entitled to maintain the action below for infringement of the Shoup patent. The action should have been dismissed upon the threshold issue of title for lack of title to the patent, and hence for lack of a proper party plaintiff.

The documents of record below relating to the issue of ownership, considered in chronological order, and which themselves disclose title to now be in the Shoup Engineering Corporation, are:

(a) A Subscription Agreement (Appendix G in the Separately Filed Appendix to This Petition)

This Subscription Agreement (unauthenticated and unrecorded) dated March 14, 1961 obligated Allen Shoup, signatory thereto, to assign in the future to a corporation not yet in legal existence to be known as "Shoup Engineering Corp.", for his shares of stock to be received, his rights briefly identified as—

> "All right, title and interest in the design, patent, labor and material and any other right in a smokeless electric broiler, Broilitizer by trade name and general recognition".

This "Subscription Agreement" was *not* an instrument in writing then assigning a patent application, a patent or an interest therein. It was a mere contract to assign in the future.

(b) An "Assignment" of October 25, 1963 From Shoup Engineering Corporation to the Irene Schneider Trust (Appendix H in the Separately Filed Appendix to This Petition)

This "Assignment" *purported* to be an assignment on October 25, 1963 by Shoup Engineering Corporation (which did not on that date possess *any* title) to the "Irene Schneider Trust", of all rights, title and interest in patent application 88,868 (the application for the patent in suit), "EXCEPT FOR A PREVIOUS ASSIGNMENT FOR FIVE THOUSAND ($5,000.00) DOLLARS."

This "Assignment" conveyed *nothing* from Shoup Engineering Corporation which then held *no* title. In any event, *if* Shoup Engineering Corporation then transferred any title, it was *not full title* to the application. The "assignment" *expressly* stated that the transfer of title was not complete because of this *previous* assignment to some one not there identified. Presumably, this "previous assignment" was an assignment of a partial interest in the patent. There is no evidence on this point. The "Irene Schneider Trust", by the express terms of the October 25, 1963 "assignment", was therefore *put on notice* that there was another co-owner someplace by virtue of that "previous assignment".

This "assignment" of October 25, 1963 did not convey *any* title to the Irene Schneider Trust because Shoup Engineering Corporation at the time held no title. In any event, this "assignment" did not convey *complete* title because of the recited "previous assignment".

(c) An "Assignment" of January 21, 1965 From Allen A. Shoup to Shoup Engineering Corporation (Appendix I in the Separately Filed Appendix to This Petition)

On January 21, 1965, Allen A. Shoup, the named inventor of the patent in suit stated that *"I hereby* assign, transfer and set over" to Shoup Engineering Corporation his patent application Serial No. 88,868. He added that the assignment was being made in performance of his contractual obligation set forth in the March 14, 1961 Subscription Agreement (Appendix G) for the stock in the corporation by inserting in the assignment the notation that it was made "nunc pro tunc as of March 14, 1961, *pursuant* to a subscription agreement executed as of that date".

Of course, title passed to Shoup Engineering Corporation on January 21, 1965 when the written assignment was made. The "nunc pro tunc" recital could not change the Subscription Agreement of March 14, 1961 into a written assignment because the "assignee" at that earlier time was *not in existence.* The phrase "nunc pro tunc" is properly used to accomplish something which *should* have been done earlier but was not because of an inadvertence. In the present instance, no assignment *could* have been made back on March 14, 1961 because Shoup Engineering Corporation *did not exist.*

As a result, the Assignment of January 21, 1965 must stand as of its own date. Hence title to the Shoup patent now *resides solely* in the Shoup Engineering Corporation. It alone possesses the right to sue on the patent.

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(d) An "Assignment" of August 3, 1968 From the Irene Schneider Trust to Marian Shoup (Appendix J in the Separately Filed Appendix to This Petition)

On August 3, 1968 the Irene Schneider Trust *purported* to assign full title to the patent in suit to Marian Shoup, the Respondent.

However, on that date the Irene Schneider Trust, as we have seen, did not possess any title, and in any event did not possess full title. When the Irene Schneider Trust was proceeding on the pretense that it had itself received title from the Shoup Engineering Corporation by the "Assignment" of October 25, 1963, the fact is that on that date of October 25, 1963, the Shoup Engineering Corporation possessed *no* title whatever which it could transfer. The Shoup Engineering Corporation did not receive title until January 21, 1965 when Allen A. Shoup first assigned his title to the corporation. Furthermore, *if* the Shoup Engineering Corporation on October 25, 1963 had any title (but which is denied), it is definite that *full title* was not even being purported to be transferred to the Irene Schneider Trust. This is clear from the reservation in the purported assignment of October 25, 1963 that title "EXCEPT FOR A PREVIOUS ASSIGNMENT FOR FIVE THOUSAND ($5,000.00) DOLLARS" was being conveyed.

Thus, by the purported "assignment" of August 3, 1968, the Irene Schneider Trust received *nothing*, and certainly did not receive full title.

It was *impossible* for the Irene Schneider Trust to legally convey full title to the patent in suit to Marian Shoup, the Respondent.

It thus appears from the written assignment instruments, which Congress has provided by 35 U.S.C. 261

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govern the manner in which title is conveyed, that title to the Shoup patent resides in the Shoup Engineering Corporation and not in the Respondent.

Choosing to disregard these written assignment instruments in the record, the courts below elected to borrow and depend upon the determination of title as made by some unknown person in the Patent Office in performing the clerical work of printing the patent. When confronted with the question of whether the statutory provision for transfer of legal title, 35 U.S.C. 261, that is, the written assignment instruments of record, should govern, or whether the mistaken conclusion of some unknown clerk in the Patent Office should govern, the courts below abdicated their judicial determination of title to that unknown clerk.

This abdication of authority, and the delegating of such judicial responsibility to some person not possessing the legal authority and not shown to have the judicial competence to render such judgments, is revealed in the ruling of the District Court on title and affirmed by the Court of Appeals. In the District Court's Memorandum Opinion And Order of October 15, 1974, Appendix B to this Petition, ruling on the issue of title, the District Court ruled:

> "On March 23, 1965, the patent issued, and on its face was issued to Irene Schneider Trust by assignment from Allen A. Shoup. The Court *accepts this statement on the face of the patent as prima facie evidence of ownership at that date.* It is not necessary to consider the contention that this recitation was the result of a Patent Office error, since the alleged infringer has no standing in any event to raise that issue."

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> "Defendant here charged with infringement has a right to insist that it need respond only to the owner of the patent. That owner, however, for purposes of this action, is *presumed to be* the owner reflected on the Patent Office records. Such owner in this case is Marian Shoup. The *burden* of overcoming the correctness of this record *is on defendant.* It is a burden defendant has not met. Therefore, defendant's motion to dismiss for want of a proper party plaintiff is denied." (Emphasis added)

This initial ruling on title was merely adopted by the District Court in its June 4, 1975 Findings Of Fact, Conclusions Of Law And Judgment Order (Appendix C to this Petition) wherein it concluded (adopting verbatim the finding submitted by Respondent) in Finding 2 that Respondent "has the entire right, title and interest in and to U.S. Patent No. 3,174,863, together with the right to sue and recover for past infringement thereof", and in Conclusion Of Law 3 that Respondent "is the owner of the Shoup patent No. 3,174,863".

The Court of Appeals adopted this same election of the District Court to depend upon the incorrect notation of title as then being in the Irene Schneider Trust as printed on the patent when issued rather than upon the written assignment instruments of record showing title to be in the Shoup Engineering Corporation, as shown by its Order of affirmance (Appendix A to this Petition) wherein the Court of Appeals stated:

> "At the evidentiary hearing on the question of the nature and extent of plaintiff's ownership of the patent in suit, plaintiff presented documents and oral evidence in support of her claim of ownership. Defendant introduced no direct evidence but by virtue

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of cross-examination and oral argument addressed to the documentary evidence, contended that plaintiff did not make out a prima facie showing of ownership in discharge of her burden to do so.

The trial court held that Marian Shoup is the owner of all right, title and interest in and to the patent in suit and had the capacity to bring this action as plaintiff. Based upon our independent examination of the record, as well as our consideration of the trial court's memorandum of decision, we hold that the trial court did not err in so ruling. *We approve of and adopt the initial memorandum of decision* of the trial court on this issue. *Shoup v. Marshall Field & Co.*, N.D. Ill., ... F. Supp. ..... (October 15, 1974)."

The mistake made by the Patent Office clerical personnel in printing the erroneous notation on the heading of the patent might be attributed to confusion arising from the fact that there were sent into the Patent Office for recording on the same day *both* the:

Assignment of October 25, 1963 from Shoup Engineering Corporation, at a time when it possessed *no* title, to the Irene Schneider Trust, and the

Assignment of January 21, 1965 from Allen A. Shoup, who as named inventor *had* original title, to the Shoup Engineering Corporation, present record owner of title.

Both of these assignments were recorded January 22, 1965, two months prior to the issuance of the Shoup patent on March 23, 1965.

The "Subscription Agreement" of March 14, 1961, not being an assignment or even purporting to be an assign-

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ment, was not recorded or even presented for recording. It was ignored as an element in seeking any purported claim of title to the Shoup patent to be in the Irene Schneider Trust and hence to Respondent.

The Respondent, claiming title through the Irene Schneider Trust which itself had no title, possessed no title, if the determination of title is to be based on the written assignment instruments of record rather than on the mistaken conclusion of an unknown clerk in the Patent Office, having neither the competence nor authority to determine title from the two assignment instruments sent on the same date for recording.

REASONS FOR GRANTING WRIT

1. Petitioner Is Entitled to Be Sued for Infringement Only by the Owner of 100% of Title to the Patent, and Is Not to Be Left Vulnerable to Another Suit That Could Be Brought by the True Owner of the Patent, Not a Party to the Action Below.

Under the provisions of 35 U.S.C. 281, "A *patentee* shall have remedy by civil action for infringement of *his* patent". A "patentee" is the owner of the patent. In the first instance, the named inventor is the owner and hence the patentee. If there has been a transfer of ownership by the named inventor, then the one receiving ownership through written assignment instrument is the patentee. Of course, a purported "assignment" from someone not possessing title is a nullity and conveys nothing. It is the true holder of complete ownership of a patent who as patentee is entitled to sue and recover for its infringement.

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A court has no jurisdiction to proceed with a patent infringement action unless there are represented as plaintiffs *all* owners of the patent.

> *Independent Wireless Tel. Co. v. Radio Corp. of America*, 269 U.S. 459, 468, 46 S. Ct. 166, 70 L. Ed. 357 (1926);
>
> *Switzer Bros. Inc. v. Chicago Cardboard Co.*, 252 F.2d 407, 116 USPQ 277 (7 Cir. 1958).

Proof of ownership of the complete patent is a *requisite* to the right to sue for infringement:

> *Agrashell Inc. v. Hammons Products Co.*, 352 F.2d 443, 147 USPQ 347 (8 Cir. 1965);
>
> *Layne-New York Co. v. Allied Asphalt Co.*, 501 F.2d 405, 183 USPQ 132 (3 Cir. 1974).

The District Court below in the course of the evidentiary hearing of July 11, 1974 on the question of title *then* recognized this well established principle of law by the statement:

> "The Court. We have cross motions for summary judgment on the issue of title, and of course, *if the plaintiff has not established title,* I think it disposes of the underlying case".

In a patent infringement action the burden is on the plaintiff to prove by competent evidence *full ownership* of the patent and of the capacity to bring the action as party plaintiff:

> *Crown Co. v. Nye Tool Works*, 261 U.S. 24, 43 S. Ct. 254 (1923);
>
> *Kulesza et al. v. American Car & Foundry*, 111 F.2d 58, 44 USPQ 488 (7 Cir. 1940);

Switzer Bros. v. Byrne, 242 F.2d 909, 113 USPQ 168 (6 Cir. 1957).

Thus, it was incumbent upon the Respondent to prove her full ownership of the Shoup patent. It was not incumbent upon the Petitioner to prove the negative, that is to prove that Respondent did not own the patent. Yet such lack of ownership *was* established by the *only* competent evidence of record on the issue of title. The written assignment instruments of record all conclusively establish that title resides in the Shoup Engineering Corporation and not in the Respondent. The contrary mistaken notation erroneously printed on the patent does not, and can not, cancel and negative the show of title evidenced by the written assignment instruments of record, which are the only means of conveying title under the authority of the statute, 35 U.S.C. 261.

The absence of any ownership of the Shoup patent by Respondent necessarily leaves Petitioner vulnerable to a later action for infringement of the same patent by Shoup Engineering Corporation (or by a presently unknown person or firm to whom Shoup Engineering Corporation may have since assigned the patent, if any).

The Respondent is in fact and in law a stranger to title to the patent and possessed no right whatever to bring the action against Petitioner. The error of the Courts below has been in ignoring the statutory provisions for transfer of title to a patent and thus improperly leaving Petitioner to the peril and risk of being later sued for infringement. The Respondent has no more right to a recovery for infringement of the patent than would any stranger.

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2. There Is No Statutory Power or Authority Granted to Patent Office Clerks to Determine the Issue of Title Based Upon Their Interpretation of the Assignment Instruments Presented for Recording, But Rather It Is a Judicial Function to Determine the Issue of Title Based Upon the Only Evidence That Congress Has Provided for Showing Transfers of Title to Patents, That Is Written Assignment Instruments As Set Forth in 35 U.S.C. 261.

It is important to the preservation of the legal system that rights, such as ownership of patents, be judicially determined on the basis of legal and competent evidence. Such a determination of legal rights should not be lightly passed off and delegated to unknown clerical personnel in any agency of the Government.

Petitioner was not a party to the determination of title as made by Patent Office personnel and as appearing in the printed notation on the patent when issued. That determination was made without a hearing and without an opportunity for the Petitioner to be heard by the Patent Office in the course of the unofficial determination made when printing the patent.

Petitioner had and has the legal right to be sued for infringement only by the true holder of all legal title to the patent. Yet, that right has been denied the Petitioner by the simple expedient of the courts below in depending upon the unofficial determination made by unknown Patent Office clerical personnel handling the printing of the patent. The Petitioner has been denied the legal right to be sued only by the legal owner through the admitted election of the lower courts to disregard the written assignment records and to instead adopt and to depend upon the false notation printed on the patent.

If one were sued for alleged trespass upon real property, besides denying the trespass, it would not be considered to be a mere "technical defense" to point out that the plaintiff was a stranger to title and that according to the written deeds of conveyance, the property was really owned by another.

There has not been found any other decision wherein the legal right—that is, the legal right to be sued only by the legal owner of a patent—was denied on the basis of an erroneous notation concerning title printed on a patent. Heretofore, the courts have followed the statute in recognizing only written assignment instruments as evidence of legal title to a patent. So far as known, the courts have not followed the practice of permitting an agency to make such a legal determination in the place and stead of a judicial determination by the courts.

The Second Circuit Court of Appeals in a recent decision involving a legal determination of rights to a copyright declined to adopt the determination of the legal right as had been made by personnel of the Copyright Office. Rather, the Second Circuit Court of Appeals insisted on making a *judicial* determination based on the law and the evidence. In this parallel decision involving the legal right to a copyright, the Court said:

> "Judge Owen also relied on the form provided by the Register of Copyrights (Circular 1B) which defines 'posthumous' as a 'work first published and copyrighted after the death of the author.' And *yet the Copyright Office has no authority to give opinions or define legal terms and its interpretation on an issue never before decided should not be given con-*

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trolling weight. See *DeSylva v. Ballentine,* 351 U.S. 570, 577-78, 109 USPQ 431, 433-434 (1956)."

Bartok v. Boosey & Hawkes, Inc., 523 F.2d 941, 187 USPQ 529 (2 Cir. 1975).

In the above 1956 decision cited by the Second Court of Appeals, this Supreme Court declined to adopt, and to base its decision on, the legal interpretation that had been given by the Copyright Office involving ownership of a copyright but itself made its own judgment on the question, stating:

> "Although we would ordinarily give weight to the interpretation of an ambiguous statute by the agency charged with its administration, cf. *Mazer v. Stein,* 347 U.S. 201, 211-213, 100 USPQ 325, 330-331, we think the Copyright Office's explanation of its practice deprives the practice of any force as an interpretation of the statute, and we therefore do not rely on it in this instance."

DeSylva v. Ballentine, 351 U.S. 570, 109 USPQ 431 (1956).

3. As a Matter of Safe Public Policy, the Legal Rights of Petitioner Should Not Be Dependent Upon the Discretion, Whim, Caprice, or Mistake of an Unknown Patent Office Clerk Not Authorized to Make a Legal Determination of Title, and Not Known to Have the Competency to Make Such a Legal Determination.

It is important to the liberties and property of all citizens that their legal rights be determined by the courts on the basis of competent legal evidence, and not be determined by unknown agency personnel in an ex parte

procedure wherein the determination may be based on the mistake, whim, caprice, carelessness or possible fraud on the part of such personnel.

Such a safe public policy has been violated here where the lower courts have knowingly chosen to adopt and use the fallacious determination by a Patent Office clerk that the Shoup patent when issued was owned by the Irene Schneider Trust in the face of, and despite, all the competent evidence found in the written assignment instruments of record that the patent was owned by the Shoup Engineering Corporation.

This safe public policy based on fairness and just treatment is an aspect of due process of law to which the Petitioner should be held entitled.

An account of the manner in which the Courts below treated such an important right of Petitioner when sued for patent infringement, provides its own commentary.

CONCLUSION

The fundamental right of an alleged patent infringer to be sued only by the legal owner of the patent has been denied to Petitioner.

The Petitioner has been left vulnerable to a later action brought by the true owner of the patent as established by all the written assignment instruments of record by the award of judgment by the courts below in favor of Respondent, a stranger to title.

Legal determination of title to a patent monopoly granted by the Federal Government is not to be made by unknown personnel in the Patent Office but is to be made

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by the courts on the basis of written assignment instruments conveying title in accordance with the provisions of 35 U.S.C. 261.

There is a conflict between the Seventh Circuit judgment below as relating to ownership of a patent and the decisions both of this Court and of the Second Circuit Court of Appeals as relating to ownership of a copyright.

The decisions below are deserving of review by this Supreme Court by means of a Writ of Certiorari.

A reversal of the judgment below will aid in clarifying and making definite the patent laws and particularly the law relating to the right to sue for patent infringement.

Respectfully submitted,

BRUCE B. KROST
WOODLING, KROST, GRANGER & RUST
DALLETT HOOPES
CLARENCE J. FLEMING
McDOUGALL, HERSH & SCOTT
Attorneys for Marshall Field & Co., Petitioners

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APPENDIX A-1

Opinion of Court of Appeals

(Dated March 1, 1976)

No. 75-1729

UNITED STATES COURT OF APPEALS
For the Seventh Circuit

MARIAN SHOUP,
Plaintiff-Appellee,

vs.

MARSHALL FIELD & COMPANY,
Defendant-Appellant.

ORDER

We are concerned here with questions of validity and infringement of United States Patent No. 3,174,863, entitled "Smokeless Broiler." The patent was issued on February 13, 1961, to the inventor Allen A. Shoup, now deceased. Plaintiff Marian Shoup is the inventor's widow and claims the entire right, title and interest in the Shoup patent.

Defendant Marshall Field & Company has sold Dominion smokeless electric broilers in this district which are alleged to infringe the Shoup broiler. Dominion Electric Corporation, now succeeded by Scovill Manufacturing Company, manufactures the Dominion broiler and is defending this action on behalf of Marshall Field & Company.

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Initially in this proceeding, on May 10, 1971, the district court granted defendant's motion for summary judgment for non-infringement only of the Shoup patent. On appeal to our court, we reversed this summary judgment on March 1, 1973, by an unpublished order and remanded the cause for trial on the merits.

By counterclaim, defendant raised the issue of whether plaintiff had title in the patent and capacity to sue. This issue, as well as others, were tried to the court without the intervention of a jury. Following a hearing on this issue, the trial court held plaintiff to be the owner of the patent in suit and a proper party plaintiff. Defendant's motion for reconsideration was denied.

Next followed a trial on the issues of validity and infringement. After considering all elements of these issues and the defenses thereto, the trial court entered appropriate findings of fact and stated conclusions of law, with a resulting judgment for plaintiff. Briefly, the court held the Shoup patent to be valid and infringed by the Dominion broiler and enjoined defendant from further infringement. Defendant's counterclaim asserting affirmative defenses was dismissed with prejudice. Defendant was ordered to pay plaintiff such damages arising from the patent infringement as might be determined by an accounting. Other questions of relief, including costs, increasing damages, interest and attorney's fees were reserved until the accounting period.

Defendant has appealed from the final judgment.

I.

At the evidentiary hearing on the question of the nature and extent of plaintiff's ownership of the patent in suit, plaintiff presented documents and oral evidence in

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support of her claim of ownership. Defendant introduced no direct evidence but by virtue of cross-examination and oral argument addressed to the documentary evidence, contended that plaintiff did not make out a prima facie showing of ownership in discharge of her burden to do so.

The trial court held that Marian Shoup is the owner of all right, title and interest in and to the patent in suit and had the capacity to bring this action as plaintiff. Based upon our independent examination of the record, as well as our consideration of the trial court's memorandum of decision, we hold that the trial court did not err in so ruling. We approve of and adopt the initial memorandum of decision of the trial court on this issue. *Shoup v. Marshall Field & Co.*, N.D. Ill., ... F. Supp. ..... (October 15, 1974).

II.

At the conclusion of the trial on the issues of validity and infringement, the district court filed 66 findings of fact and entered 24 conclusions of law, followed by an appropriate judgment favorable to the plaintiff. Based upon our consideration of the record as a whole, together with the briefs and oral arguments of all parties, it is our considered judgment that the district court's findings are not clearly erroneous and find substantial support in the record and that the conclusions correctly state the applicable law with appropriate citations of authority.

The trial court found that the representative prior art shows both overfired and underfired broilers, but does not teach a smokeless and flameless broiler. The prior art relied on by defendant does not teach a smokeless and flameless broiler. The district court's findings Nos. 22 through 30 specifically consider and distinguish the prior art relied upon by defendant.

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During the trial, tests were performed before the trial judge which proved to his satisfaction that the Shoup Model No. 5 broiler and also the Toastmaster, Farberware, Cory and the alleged infringing Dominion broilers were smokeless and flameless broilers. No tests were performed by defendant, and defendant's attending expert did not testify as to the results. The manufacturers of the Toastmaster and Cory broilers were licensed under the Shoup patent. The Shoup broiler was developed and sold prior to the other broilers tested. The Black Angus B-67 broiler, which preceded the Shoup patent, was also tested but did not operate smokelessly and flamelessly.

Upon careful consideration of the contentions both pro and con, we have concluded that Rule 52(a), Federal Rules of Civil Procedure, 28 U.S.C., is applicable here. As hereinabove stated, we hold that the findings of fact entered by the trial court are not clearly erroneous.

Accordingly, on the authority of Judge McGarr's findings, conclusions and memorandum of decision, *Shoup v. Marshall Field & Co.*, N.D. Ill., ... F. Supp. ..... (June 4, 1975) which we adopt, the judgment appealed from is in all respects affirmed.[1]

The clerk of this court is directed to enter an appropriate order of affirmance, with costs to be paid by defendant.

AFFIRMED.

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1. The final judgment order was amended by the trial court to eliminate any injunctive relief against Scovill Manufacturing Company.

APPENDIX A-2

Judgment Entry of the Court of Appeals

(Dated March 1, 1976)

No. 75-1729

UNITED STATES COURT OF APPEALS
For the Seventh Circuit

MARIAN SHOUP,
Plaintiff-Appellee,

vs.

MARSHALL FIELD & COMPANY,
Defendant-Appellant.

Appeal From the United States District Court for the Northern District of Illinois Eastern Division, No. 69 C 1682, Frank J. McGarr, Judge.

This cause came on to be heard on the transcript of the record from the United States District Court for the Northern District of Illinois, Eastern Division, and was argued by counsel.

On consideration whereof, it is ordered and adjudged by this court that the judgment of the said District Court in this cause appealed from be, and the same is hereby, AFFIRMED, with costs, in accordance with the order of this Court entered this date.

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APPENDIX B

Opinion and Order of District Court

(Dated October 15, 1974)

No. 69 C 1682

IN THE UNITED STATES DISTRICT COURT
For the Northern District of Illinois
Eastern Division

MARIAN SHOUP,
Plaintiff,

v.

MARSHALL FIELD & COMPANY,
Defendant.

MEMORANDUM OPINION AND ORDER

This is a civil action brought by Marian Shoup for the alleged infringement of a patent on a smokeless broiler, the alleged infringer being the defendant Marshall Field & Company. The case has had a long history, including an appeal, reversal, and remand. In recent months and upon the eve of trial, the defendant moved for summary judgment on the threshold issue of patent ownership, claiming to possess newly-discovered evidence that the plaintiff does not possess a sufficient title in the patent to maintain this suit.

After a denial of this defendant's motion for summary judgment on the grounds that there exists a material issue of fact, the Court ordered a hearing for the resolution of the facts upon which to predicate a decision as to title,

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recognizing that ownership in the patent was a condition precedent to the plaintiff maintaining this action.

On July 11, 1974, an evidentiary hearing was had on the question of the nature and extent of the plaintiff's ownership of the patent in suit. In the relevant allegation of the complaint, plaintiff Shoup alleges that she is the widow of Allen A. Shoup and the owner of the entire right title interest in and to said United States Letters Patent No. 3,174,863, together with the right to recover for any and all past infringement of said Letters Patent. Defendant, in its answer, denies the allegation of ownership.

At the hearing, plaintiff presented documents and oral testimony in support of the allegation of ownership. Defendant introduced no direct evidence but by virtue of cross examination and arguments addressed to the documentary evidence, contends that the plaintiff did not make a prima facie showing of ownership.

The evidence establishes that, as of the date of the issuance of the patent, that is March 23, 1965, the patent in suit was granted to the Irene Schneider Trust. The Court finds the following events relevant to the chain of title to this patent:

On March 23, 1965, the patent issued, and on its face was issued to Irene Schneider Trust by assignment from Allen A. Shoup. The Court accepts this statement on the face of the patent as prima facie evidence of ownership at that date. It is not necessary to consider the contention that this recitation was the result of a Patent Office error, since the alleged infringer has no standing in any event to raise that issue.

Plaintiff's Exhibit 5, on assignment dated August 5, 1968, transfers ownership in the patent from the Irene

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Schneider Trust to Marian Shoup. This assignment was recorded with the Patent Office on August 12, 1968. Other exhibits reflect the title to the patent to have been the subject of a Walworth County Circuit Court order arising out of creditors' claims, and include a variety of other documents which may or may not be inconsistent with the contentions as to title advanced by plaintiff. Defendant, of course, was not party to this litigation or to these agreements.

Patent Office records reveal that between the filing date in 1961 and the date of allowance in 1965, there is recorded a March 4, 1961 assignment from Inventor Allen Shoup to Shoup Engineering Corporation, and a 1963 assignment from Shoup Engineering Corporation to the Irene Schneider Trust.

The late nunc pro tunc filing of the first of these assignments does not derogate from the Court's conclusion that as to all persons not party to these assignments, including defendant Marshall Field, the owner of the patent in issue as of August 3, 1968 was and is plaintiff, Marian Shoup.

Defendant here charged with infringement has a right to insist that it need respond only to the owner of the patent. That owner, however, for purposes of this action, is presumed to be the owner reflected on the Patent Office records. Such owner in this case is Marian Shoup. The burden of overcoming the correctness of this record is on defendant. It is a burden defendant has not met. Therefore, defendant's motion to dismiss for want of a proper party plaintiff is denied.

The Court finds that the challenge to plaintiff's ownership right in the patent was an issue raised in good faith

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and not frivolous. Therefore, plaintiff's motion for the allowance of costs and fees on the title issue is denied.

ENTER:

/s/ FRANK J. MCGARR
United States District Judge

APPENDIX C

Findings of Fact, Conclusions of Law and Judgment of District Court

(Dated June 4, 1975)

No. 69 C 1682

IN THE UNITED STATES DISTRICT COURT
For the Northern District of Illinois
Eastern Division

MARIAN SHOUP,
Plaintiff,

v.

MARSHALL FIELD & CO., an Illinois corporation,
Defendant.

FINDINGS OF FACT, CONCLUSIONS OF LAW AND JUDGMENT ORDER

FINDINGS OF FACT

1. This is a civil action for infringement of U.S. Patent No. 3,174,863, entitled "Smokeless Broiler". Plaintiff seeks an injunction against infringement and damages.

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Defendant denies infringement, avers by way of affirmative defenses the patent is invalid, and counterclaims for declaratory judgment that the patent is invalid and not infringed by defendant.

2. United States Letters Patent 3,174,863 was duly and legally issued to Allen A. Shoup, now deceased, on February 13, 1961.

3. The plaintiff, Marian Shoup, is the widow of the inventor, Allen A. Shoup; was at the time of filing this action a resident of Chicago, Illinois; is now a resident of Tustin, California; and has the entire right, title and interest in and to U.S. Patent No. 3,174,863, together with the right to sue and recover for past infringement thereof.

4. The defendant, Marshall Field & Co., is an Illinois corporation having an office and principal place of business at Chicago, Illinois; and has sold Farberware and Dominion smokeless electric broilers in this district which are alleged to be infringed.

5. The Farberware broiler is made by the S.W. Farber Division of Walter Kidde & Co.; and the complaint was dismissed as to the Farberware infringement on December 24, 1970, pursuant to a license granted to Walter Kidde & Co.

6. Dominion Electric Corp., now succeeded by Scovill Manufacturing Co., makes the Dominion smokeless electric broiler, and has defended this action on behalf of the defendant, Marshall Field & Co.

7. This Court has jurisdiction over the parties and the subject matter of the complaint, and venue is properly laid in this judicial district as to defendant, Marshall Field & Co.

8. The patent in suit relates to an electric broiler for cooking foods, and the invention lies in structuring the broiler to cook foods substantially without smoke and flame. Primarily, the invention is concerned with the cooking of meats from which fats are driven during the application of heat thereto, and more particularly, to the cooking of meats so that the fats may be most readily removed therefrom, and in this regard the meat is supported on a grill beneath which the heating element is arranged so that the fats exuding from the meat fall downwardly from the undersurface of the meat. The invention is further concerned with the nearly complete elimination of smoking and flaming caused by burning fats so that the meat being cooked is not subjected to the smoking and flaming products of burning fats, and so that the broiler may be used within a home without necessitating the venting of the cooking surface to the outside atmosphere.

During operation of the broiler, the structural components are maintained outside of the smoke and flame temperature range of fats so that any fats contacting any components of the broiler will not smoke or flame. The heating element is maintained above the smoke and flame temperature range, while the other structural components are maintained below the smoke and flame temperature range. Fats falling onto the heating element roll off and fall to the bottom of the broiler and do not smoke or flame. Fats collecting in the bottom of the broiler do not smoke or flame, and fats adhering to the grill do not smoke or flame.

9. Allen A. Shoup, inventor of the patent in suit, commenced in 1958 development of a broiler that could be used indoors. In 1960, he completed his invention of a smokeless and flameless broiler that could be used indoors and which cooked foods by broiling.

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10. In 1961, Allen Shoup commenced manufacture of his invention in Wisconsin.

11. On February 13, 1961, Allen A. Shoup filed a patent application which matured into the patent in suit.

12. Plaintiff Marian Shoup owned and operated a restaurant in Chicago in 1961 and met Allen Shoup in early 1961 when he was a patron at the restaurant.

13. Allen Shoup brought one of his smokeless and flameless broilers to plaintiff's restaurant for her use and on which she cooked hamburgers and other foods.

14. Plaintiff married Allen Shoup on June 16, 1961, and Mr. Shoup died May 4, 1965.

15. Plaintiff assisted Allen A. Shoup in the marketing of the smokeless broiler invention by attending trade shows and demonstrating the operation of the broiler.

16. Plaintiff served as a model in connection with the broiler invention on advertising and instructional materials.

17. Allen A. Shoup first developed and marketed a Model 1 broiler and next developed and marketed a Model 2 broiler, and finally developed and marketed a Model 5 broiler.

18. During operation of the Shoup Model 5 broiler, fats on the grill, falling between and onto the heating surfaces of the heating element, and falling onto the surface below the heating element, will not smoke or flame.

19. The Shoup Model 5 broiler operates smokelessly and flamelessly.

20. The representative prior art shows both overfired and underfired broilers, but does not teach a smokeless and flameless broiler.

21. The prior art relied on by the defendant does not teach a smokeless and flameless broiler.

22. The U.S. Davis Patent 1,504,102 does not recognize the smoke and flame temperature range phenomena for fat, but discloses an underfired broiler which includes a catchment well at the food supporting surface for collecting fats, thereby implying that the fats would not be allowed to generally fall downwardly onto the heating element and a flue for removing fumes that may be formed by the consumption of fats dripping onto the heated corrugated plate 21, thereby implying that the corrugated plate 21 operates at a temperature that would cause smoking of fats impinging thereon.

23. The U.S. Del Francia, et al. Patent 2,813,706, while showing an underfired broiler, would not be suitable for use indoors without an exhaust hood, as it specifically intends to create flame by the burning of fat during the broiling of foods.

24. The U.S. Joseph Patent 2,903,549, while showing an underfired broiler, positions the heating element directly on the bed of refractory material 47 that would most certainly cause the flaming or smoking of fats impinging on the refractory bed.

25. The U.S. Bernstein Patent 2,956,497 shows an overfired broiler which is not at all pertinent to the Shoup invention.

26. The Australian Patent 17523/34, while showing an underfired broiler, would not be suitable for indoor cooking without the use of an exhaust hood for fumes, inasmuch as it clearly contemplates smoking or flaming of fats during the cooking process.

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27. The Black Angus B-67 broiler is another example of the prior art that does not teach the principle of having a smokeless and a flameless broiler.

28. The Black Angus B-67 broiler smokes considerably more than the Shoup Model 5 broiler.

29. The Black Angus B-67 broiler is not a smokeless broiler.

30. Bacon cooked on the Black Angus B-67 broiler the same period of time as bacon cooked on the Shoup Model 5 broiler is charred, while the bacon cooked on the Shoup Model 5 broiler is not charred.

31. The Shoup patent describes a smokeless and flameless broiler in sufficiently clear, concise and exact terms as to enable any person skilled in the art of broilers to make and use the invention.

32. The Shoup patent discloses a smokeless and flameless broiler which is novel and patentable.

33. The Shoup patent discloses a smokeless and flameless broiler which would not have been obvious at the time the Shoup invention was made to a person having ordinary skill in the art of broilers.

34. The Shoup patent discloses and claims an underfired broiler for cooking foods smokelessly and flamelessly, which includes a heating element operating at a temperature such that when fats impinge thereon, they will not smoke or flame, a grill mounted above the heating element for supporting foods and spaced therefrom such that fats on the grill will not smoke or flame, a surface or grease pan mounted below the heating element spaced from the heating element such that when fats are in engagement with the heating element, they will not smoke or flame, and a support means for the heating element, grill and

grease pan arranged to operate outside the smoke and flame temperature range of fats.

35. The claims in the Shoup patent clearly point out and particularly claim the subject matter of the invention in clear and definite terms.

36. The claims in the Shoup patent are not restricted to a broiler structure where the spacing between the heating element and the grill and the heating element and the grease pan are at a precise dimension other than that which would prevent smoking or flaming of fats on the grill or on the grease pan.

37. The claims in the Shoup patent cover the smokeless and flameless broiler structure of the Shoup invention.

38. There is no single prior art patent which shows an underfired broiler that is smokeless and flameless and which meets all of the limitations of the claims in the Shoup patent.

39. The claims in the Shoup patent distinguish over the prior art relied upon by defendant, as they do not show a smokeless and flameless broiler that can be used indoors without an exhaust hood, and they do not teach the operation of a heating element above the smoke and flame temperature range.

40. No testimony was offered as to how any of the prior art references cited by defendant and the Black Angus B-67 broiler could be combined to make the Shoup invention obvious to one of ordinary skill in the art.

41. The smoke and flame temperature range phenomena of fats is not disclosed in any of the prior art patents or by the Black Angus B-67 broiler.

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42. The solving of the smokeless and flameless broiler problem is not anticipated by the prior art or by the Black Angus B-67 broiler.

43. No clear and convincing testimony or evidence was offered by defendant that the Shoup invention was obvious in view of the prior art, or in view of the Black Angus B-67 broiler at the time the Shoup invention was made.

44. While it appears an attempt was made in the development of the Black Angus B-67 broiler to provide a broiler that would be smokeless and flameless, such attempt failed.

45. The Shoup smokeless and flameless broiler was developed and sold prior to the Dominion smokeless and flameless broiler.

46. Subsequent to the development and sale of the Shoup broiler, many other smokeless broilers were marketed, including the Dominion broiler, the Farberware broiler, the Toastmaster broiler.

47. The Toastmaster broiler is made by McGraw Edison.

48. The Farberware broiler is made by the S.W. Farber Division of Walter Kidde & Co.

49. The Cory broiler is made by Cory Corp. and is the same as the Shoup broiler Model 5.

50. The Toastmaster broiler, the Farberware broiler, the Cory broiler and the Dominion broiler were first made subsequent to the Shoup broiler.

51. The manufacturers of the Toastmaster broiler, the Cory broiler and the Farberware broiler were licensed under the Shoup patent.

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52. McGraw Edison, S.W. Farber and Dominion all obtained patents on their broilers subsequent to the Shoup patent.

53. The Toastmaster broiler and the Farberware broiler operate smokelessly and flamelessly.

54. The Dominion broiler includes a heating element operating above the smoke and flame temperature range of fats, together with a grill spaced above the heating element such that fats on the grill will not smoke or flame, and a grease pan spaced below the heating element such that when fats impinge on the grease pan, they will not smoke or flame, whether or not the reflective shield is positioned in the grease pan.

55. While cooking bacon on the Dominion broiler, fats falling on the reflector in the grease pan do not smoke or flame, fats hitting the heating element do not smoke or flame, but just roll off and drop into the pan, and fats hitting the pan with the reflector removed do not smoke.

56. During operation of the Dominion broiler and the cooking of bacon thereon, the only smoke observed came from the underside of the bacon and the central portion where sufficient heat is trapped to raise the temperature of the fats to cause them to smoke.

57. Claims 1 and 3 to 6 define the Shoup invention in terms of a broiler structure with elements arranged to avoid smoking and flaming during the cooking of foods.

58. Claim 2 defines a method of broiling foods which essentially consists of operating the broiler of the Shoup invention during the cooking of foods thereon.

59. Claim 3 differs from Claims 1, 4, 5 and 6 in that it additionally defines having water in the pan for facilitating the removal of fats therefor.

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60. Claim 5 differentiates from Claims 1, 3, 4 and 6 in defining means operating outside the smoke and flame temperature range for shielding the intermediate supporting means against falling fats.

61. Claims 1 and 3 to 6 clearly cover a broiler utilizing as a heating element a Calrod, as shown in Figs. 5 and 6 of the patent.

62. The operation of the Dominion broiler with or without the shield in the grease pan infringes method Claim 2 of the Shoup patent.

63. The Dominion broiler with or without the reflective shield in the grease pan clearly infringes Claims 1, 4 and 6 of the Shoup patent.

64. The Dominion broiler in its latest configuration as evidenced by the deposition exhibit in the Satkunas deposition, clearly infringes Claims 1 and 4, 5, 6 in that this broiler includes a shield over the intermediate supporting means for the element.

65. The Dominion broiler clearly infringes Claim 3 wherein water could be put in the grease pan to facilitate removal of fats even though the instructions for the operation of the Dominion broiler do not specify that water be placed in the bottom of the pan.

66. The manufacturing, selling and using of the Dominion broiler infringes Claims 1 to 6 of the Shoup patent.

CONCLUSIONS OF LAW

1. This Court has jurisdiction of the parties and of the subject matter of the issues herein involved, and venue is properly laid in this district as to the defendant Marshall Field & Co.

2. Plaintiff is the owner of the Shoup Patent 3,174,863.

3. The patent and each claim thereof shall be presumed valid and the burden of establishing invalidity of the patent or any claim thereof rests upon the party asserting same under 35 U.S.C. §282. *Mumm v. Jacob E. Decker & Sons,* 301 U.S. 168, 171 (1937); *King-Seeley Thermos Co. v. Tastee Freez Industries, Inc.,* 357 F.2d 875, 879, 149 U.S.P.Q. 4, 7 (7th Cir.), *cert. denied,* 385 U.S. 817 (1966).

4. The party asserting invalidity has a heavy burden of establishing same by clear and convincing evidence. *Mumm v. Jacob E. Decker & Sons,* 301 U.S. 168 (1937); *Mercantile National Bank of Chicago v. Quest, Inc.,* 166 U.S.P.Q. 513, 421 F.2d 261, *cert. denied* (CA 7, 1970); *Hazeltine Research, Inc. v. Dage Electric Company, Inc.,* 271 F.2d 218 (CA 7, 1959).

5. In order for the patent to be invalid under 35 U.S.C. 102, it must be clearly and convincingly established that the patent, the publication, or the prior sale stand alone as a full anticipation of the invention in the Shoup patent. *Illinois Tool Works, Inc. v. Foster Grant Co., Inc.,* 181 U.S.P.Q. 553, 569 (D.C. N.D. Ill. 1974).

6. In order for the patent to be invalid under 35 U.S.C. 103, it must be clearly and convincingly established that the invention was obvious in view of the prior art at the time the invention was made. *Illinois Tool Works, Inc. v. Foster Grant Co., Inc.,* 181 U.S.P.Q. 570 (D.C. N.D. Ill. 1974).

7. That the claims in the Shoup patent do not cite the spacing dimensions between the grill and heating element and between the heating element and grease pan will not invalidate the patent under 35 U.S.C. §112. *Binks Mfg.*

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Co. v. Ransburg Electro-Coating Corp., 281 F.2d 252 (7th Cir.).

8. If there is no evidence that the existence of a problem is not known to those skilled in the art at the time of the invention, it is not proper to conclude the invention which solves this problem would have been obvious. *In re Namiya*, 184 U.S.P.Q. 607, 612-613 (CCPA, 1975).

9. When the evidence shows that others in the art attempted to solve the same problem and failed in their efforts and did not arrive at the solution claimed by the patent in suit, the statutory presumption of validity is substantially strengthened. *Reeves Instrument Corp. v. Beckman Instruments, Inc.*, 444 F.2d 263, 272, 170 U.S.P.Q. 74, 81 (9th Cir.), *cert. denied*, 404 U.S. 951 (1971); *Neff Instrument Corp. v. Cohu Electronics, Inc.*, 298 F.2d 82, 87, 132 U.S.P.Q. 98, 101, 102 (9th Cir. 1961).

10. The inquiry into patentability must be directed toward the subject matter as a whole and not to the elements of the claimed combination and their individual novelty, and therefore a patented combination which results in a more facile, economical or efficient unit, or which provides results unachieved by prior art structures, cannot be anticipated piecemeal by a showing that the various elements of the invention are individually old. *Reese v. Elkhart Welding and Boiler Works, Inc.*, 447 F.2d 517, 526 (7th Cir. 1971); *Uarco Inc. v. Moore Business Forms, Inc.*, 440 F.2d 580, 584 (7th Cir.), *cert. denied*, 404 U.S. 873 (1971); *Bela Seating Co. v. Poloron Products, Inc.*, 297 F.Supp. 489, 508 (N.D. Ill. 1968), aff'd. on other grounds, 438 F.2d 733 (7th Cir.), *cert. denied*, 403 U.S. 922 (1971).

11. The difference between the subject matter set forth in the Shoup Patent 3,174,863 and the subject matter of the cited prior art references as a whole would not have

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been obvious at the time the invention was made to a person of ordinary skill in the art to which such subject matter pertains under 35 U.S.C. §103.

12. The Shoup patent is good and valid in law and was duly granted by the United States Patent Office in accordance with the patent laws.

13. The Shoup patent particularly points out and distinctly claims the invention in accordance with 35 U.S.C. §112.

14. The Shoup patent discloses and claims patentable subject matter in accordance with 35 U.S.C. §101.

15. The Shoup patent discloses and claims a new invention that was not previously known or used, that was not previously patented or shown in a printed publication before the invention in the patent or more than one year before the filing date of the patent, that was not sold in this country more than a year before the filing date of the patent, all in accordance with 35 U.S.C. §102.

16. The Shoup patent discloses and claims a new invention that was not obvious at the time the invention was made and thus was granted in accordance with 35 U.S.C. §103.

17. Patents are not limited to the embodiment of the invention described in the specification and drawings since the patent claims measure the invention. If the accused device achieves substantially the same results in substantially the same way as the patented device, the devices are the same in the eyes of the patent law. *Graver Tank & Mfg. Co. v. Linde Air Products Co.*, 399 U.S. 605, 608 (1950); *King-Seeley Thermos Co. v. Tastee Freez Industries, Inc.*, 357 F.2d 875, 880 (7th Cir.), *cert. denied*, 385 U.S. 817 (1966).

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18. One appropriating the principle and mode of operation of a patented device, and obtaining its results by the same or equivalent means, may not avoid infringement by making a device different in form, even though it be more or less efficient than the patented device. *Reese v. Elkhart Welding and Boiler Works, Inc.*, 447 F.2d 517, 527, 171 U.S.P.Q. 129, 136 (7th Cir. 1971); *Paper Converting Machine Co. v. FMC Corp.*, 409 F.2d 344, 353, 161 U.S.P.Q. 67, 75 (7th Cir.), *cert. denied*, 396 U.S. 877 (1969); *Nordberg Mfg. Co. v. Woolery Machine Co.*, 79 F.2d 685, 692, 27 U.S.P.Q. 189, 196 (7th Cir. 1935).

19. The addition of an added element to a combination called for by a patent does not avoid infringement of the patent. *Holland Co. v. American Steel Foundries*, 190 F.2d 37, 38, 90 U.S.P.Q. 1, 2 (7th Cir.), *cert. denied*, 342 U.S. 859 (1959); *Columbia Wire Co. v. Kokomo Steel & Wire Co.*, 143 Fed. 116, 123 (7th Cir. 1905); *Henrickson v. Cory Corp.*, 140 U.S.P.Q. 286, 288, 327 F.2d 409 (CA 7, 1964).

20. Claims 1, 4 and 6 read directly on the Dominion broiler.

21. Claims 1, 3, 4, 5 and 6 read directly on the later embodiment of the Dominion broiler as identified in the Satkunas deposition where a shield is provided at the connection of the heating element with the power supply socket.

22. Claim 2 reads directly on the operation of the Dominion broiler.

23. Claim 3 reads essentially on the structure of the Dominion broiler in that water can easily be added to the grease collecting tray for facilitating removal of fats therefrom.

24. The Dominion broiler with or without the shield in the grease pan infringes the patent in suit in accordance with the tests of infringement established in this circuit. *Rockwell v. Midland Ross Corp.*, 169 U.S.P.Q. 5, 13, 438 F.2d 635 (7th Cir. 1971); *Leach v. Rockwood & Co.*, 158 U.S.P.Q. 518, 521, 404 F.2d 652 (7th Cir. 1968).

JUDGMENT ORDER

It is the judgment of the Court that the Shoup Patent 3,174,863 is valid, that the Dominion broiler infringes the Shoup patent, that the defendant be and hereby is enjoined against further infringement of the patent, that plaintiff be granted an injunction against further infringement of the patent by Scovill Manufacturing Company, that the counterclaim of defendant be dismissed with prejudice, that defendant pay to plaintiff the amount of damages arising from the patent infringement as determined by an accounting. The questions of costs, increasing damages under Title 35 U.S.C. §284, the amount and period of interest and attorney's fees under Title 35 U.S.C. §285 are reserved until the accounting period.

ENTER:

/s/ FRANK J. MCGARR
United States District Judge

APPENDIX D

Amended Judgment of District Court

(Dated June 16, 1975)

Civil Action No. 69-C-1682

IN THE UNITED STATES DISTRICT COURT
For the Northern District of Illinois
Eastern Division

MARIAN SHOUP,
Plaintiff,

v.

MARSHALL FIELD & CO.,
Defendant.

AMENDED JUDGMENT

In accordance with the Findings of Fact and Conclusions of Law entered June 4, 1975,

It is the judgment of the Court that the Shoup patent No. 3,174,863 is valid, that the Dominion broiler infringes the Shoup patent, that the defendant be and hereby is enjoined against further infringement of the patent, that plaintiff be granted an injunction against further infringement of the patent by defendant, that the counterclaim of defendant be dismissed with prejudice, that defendant pay to plaintiff the amount of damages arising from the patent infringement as determined by an accounting. The questions of costs, increasing damages under Title 35 U.S.C., §284, the amount and period of interest and attorney's fees under Title 35 U.S.C., §285, are reserved until the account-

ing period. Cause is referred to Executive Committee for assignment to a Magistrate with instructions to take evidence on the issue of accounting and damages and to make a report and recommendation to the Court.

IT IS SO ORDERED:

/s/ FRANK J. MCGARR
United States District Judge

Date June 16, 1975

APPENDIX E

Statutes Involved

35 U.S.C. 261

§ 261. Ownership; assignment

Subject to the provisions of this title, patents shall have the attributes of personal property.

Applications for patent, patents, or any interest therein, shall be assignable in law by an instrument in writing. The applicant, patentee, or his assigns or legal representatives may in like manner grant and convey an exclusive right under his application for patent, or patents, to the whole or any specified part of the United States.

A certificate of acknowledgment under the hand and official seal of a person authorized to administer oaths within the United States, or, in a foreign country, of a diplomatic or consular officer of the United States or an officer authorized to administer oaths whose authority is proved by a certificate of a diplomatic or consular officer of the United States, shall be prima facie evidence of the execution of an assignment, grant or conveyance of a patent or application for patent.

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An assignment, grant or conveyance shall be void as against any subsequent purchaser or mortgagee for a valuable consideration, without notice, unless it is recorded in the Patent and Trademark Office within three months from its date or prior to the date of such subsequent purchase or mortgage.

As amended Jan. 2, 1975, Pub.L. 93-596, § 1, 88 Stat. 1949.

35 U.S.C. 152

§ 152. Issue of patent to assignee

Patents may be granted to the assignee of the inventor of record in the Patent and Trademark Office, upon the application made and the specification sworn to by the inventor, except as otherwise provided in this title.

As amended Jan. 2, 1975, Pub.L. 93-596, § 1, 88 Stat. 1949.

35 U.S.C. 281

§ 281. Remedy for infringement of patent

A patentee shall have remedy by civil action for infringement of his patent. July 19, 1952, c. 950, § 1, 66 Stat. 812.

SUPREME COURT, U. S.

FILE
APR 5
MICHAEL RODAK,

Supreme Court of the United States

October Term, 1975

No. 75-1405

MARSHALL FIELD & CO.,
Petitioner,

vs.

MARIAN SHOUP,
Respondent.

ADDITIONAL APPENDIX TO PETITION FOR A WRIT OF CERTIORARI

To the United States Court of Appeals
For the Seventh Circuit

BRUCE B. KROST
WOODLING, KROST, GRANGER & RUST
655 Union Commerce Building
Cleveland, Ohio 44115

DALLETT HOOPES
c/o SCOVILL MANUFACTURING COMPANY
Scovill Square
Waterbury, Connecticut 06720

CLARENCE J. FLEMING
McDOUGALL, HERSH & SCOTT
135 S. LaSalle Street
Chicago, Illinois 60603
Counsel for Petitioner

THE GATES LEGAL PUBLISHING CO., CLEVELAND, OHIO—TEL. (216) 621-3647

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APPENDIX F

March 23, 1965 A. A. SHOUP 3,174,863

SMOKELESS BROILER

Filed Feb. 13, 1961 2 Sheets-Sheet 1

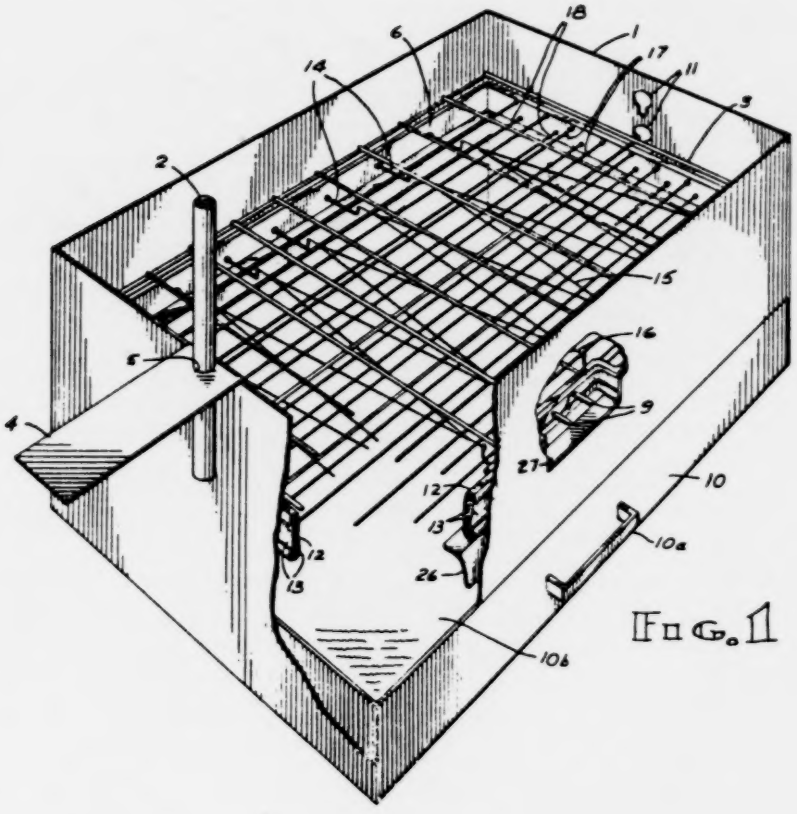
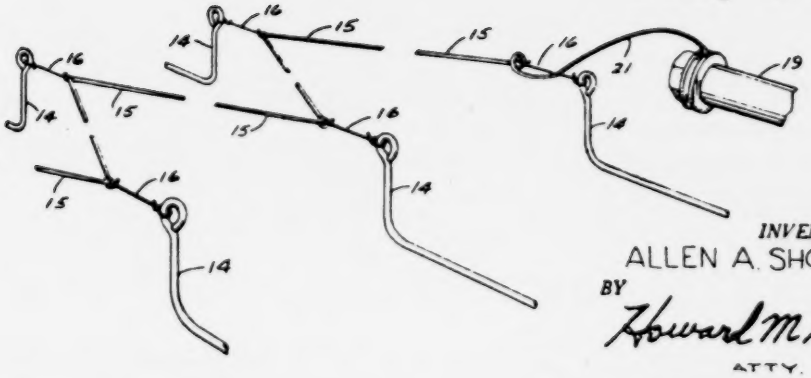


FIG. 1

FIG. 3



INVENTOR.
ALLEN A. SHOUP
BY
Howard M. Herriot
ATTY.

(2)

March 23, 1965 A. A. SHOUP 3,174,863

SMOKELESS BROILER

Filed Feb. 13, 1961 2 Sheets-Sheet 2

FIG. 2

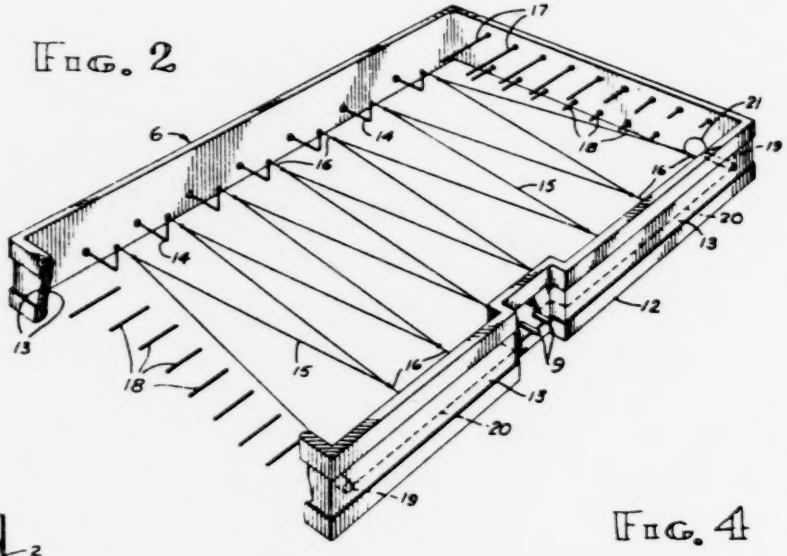
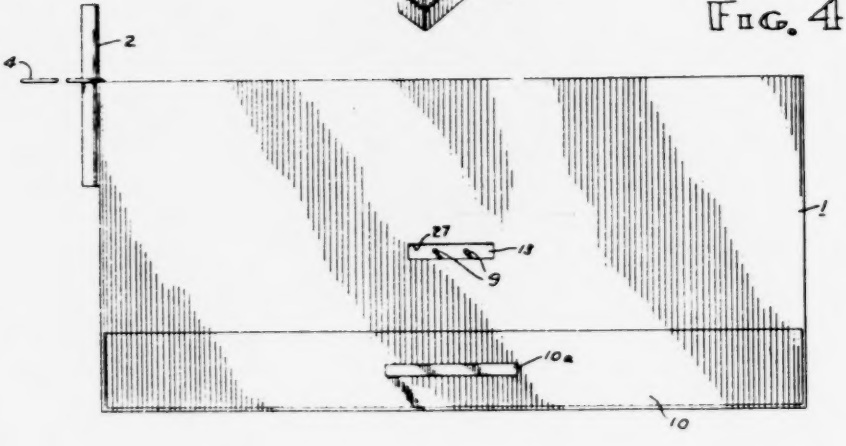


FIG. 4



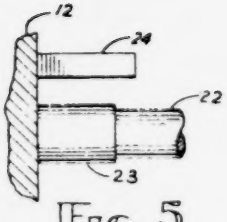


FIG. 5

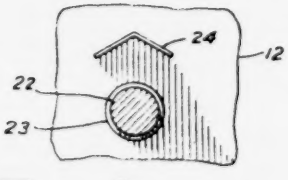


FIG. 6

INVENTOR
ALLEN A SHOUP
BY
Howard M Herriot
ATTY

United States Patent Office

3,174,863
Patented Mar. 23, 1965

3,174,863

SMOKELESS BROILER

Allen A. Shoup, Janesville, Wis., assignor, by mesne assignments, to Irene Schneider Trust

Filed Feb. 13, 1961, Ser. No. 88,868
6 Claims. (Cl. 99—1)

This invention relates in general to improved broiling means and in particular to a smokeless and flameless broiler.

The invention provides, in an electric broiler wherein a heating element is disposed directly beneath the food to minimize heat losses, means for preventing or minimizing both smoking and flaming even though fat drips down on the heating element of, and on other components of, the broiler.

Applicant has discovered that fats from foods, e.g., from meats, will not blaze or smoke upon contact with components if such components are maintained at temperatures outside of a certain range, said range hereinafter referred to as the smoke and flame temperature range. That is, if a component is cold enough, no smoke or flame will occur when fat drips thereon; and if a component is hot enough, no smoke or flame will occur when fat drips thereon. Applicant has discovered that the smoke and flame temperature range is the range of approximately 408 degrees Fahrenheit to approximately 1400 degrees Fahrenheit.

To further explain, applicant has discovered that when fat drips upon a component at a temperature of about:

Less than 408, neither smoke nor flame occurs;
Over 408 and up to 850, smoke occurs without flame, the smoking increasing with increases in temperature;
Over 850 and up to 1250, both flaming and smoking occur;
Over 1250 and up to 1400, flaming occurs without smoke; and
Over 1400, neither smoke nor flame occurs.

In prior art broilers, the components, upon which fat drips, are maintained at temperatures within the smoke and flame temperature range, and thus smoking and flaming occurs when fats drip upon such components.

Applicant has provided a new and improved broiler wherein the heating element is "hot" (i.e., is above 1400 degrees Fahrenheit, the upper end of the smoke and flame temperature range), and wherein the other components are either "cold" (i.e., below 408 degrees Fahrenheit, the lower end of the smoke and flame temperature range), or are "intermediate" (i.e., within the smoke and flame temperature range) but are shielded against contact with dripping fats by a shield, deflector or baffle which is either "cold" or "hot" and thus smoke-free and flame-free. Applicant's broiler is thus smokeless and flameless.

More particularly, the broiler of the invention includes a support means operating below the smoke and flame temperature range adapted to be mounted on a supporting surface and having a food supporting grill thereon and a heating element arranged below the grill. Intermediate supporting means is provided for supporting the heating element on the support means. The intermediate supporting means constitutes any or whatever means that may be provided between the support means and the heating element. The heating element is provided with surfaces exposed to the path of fats falling from food

supported on the grill, wherein the surfaces are spaced apart to define spaces through which fats fall even if they strike the heating element. The surfaces are operated at a temperature above the smoke and flame temperature range, wherein fats impinging thereon will fall off and through the spaces without smoking and/or flaming. The grill is spaced a sufficient distance above the heating element so that the temperature of the grill as heated by the heating element is below the smoke and flame temperature range. Moreover, the heating element is spaced a sufficient distance above a surface or pan on to which the fats fall so that the surface or pan as heated by the heating element operates below the smoke and flame temperature range. And the area below the grill through which the fats fall in which the intermediate supporting means is located is such a small portion of the entire area below the grill through which the fats fall that even though any part of the intermediate supporting means may operate within the smoke and flame temperature range, any smoke or flame produced by fats impinging thereon is negligible.

Among the objects and advantages of the invention is the provision of an electric broiler which: is smokeless, is flameless; is low in cost; cooks rapidly; cooks the fat out of the food; retains the juices and vitamins in the food; is extremely easy to clean; is of simple construction so as to minimize need of repair, yet easy to repair or service should the need arise; has a great margin of safety from both severe burns and electrical shock; is economical in the use of electricity and in minimizing shrinkage of food; cooks steaks properly searing the juices in one side without losing them out the other side; and cooks foods extremely deliciously.

These and other objects and advantages will appear from the following description, when read in conjunction with the accompanying drawings, wherein:

FIG. 1 is a perspective view of one embodiment of the broiler of this invention, with a fragment removed, to more fully disclose the details of the broiler;

FIG. 2 is a perspective view of the removable cooking unit of the broiler, with fragments removed therefrom for a clearer disclosure;

FIG. 3 is a fragmentary perspective view of the electric heating element of the removable cooking unit, and of the means supporting the electric heating element;

FIG. 4 is a front elevational view of the broiler;

FIG. 5 is a fragmentary side elevational view, partly in section of a second embodiment of the invention; and

FIG. 6 is a front elevational view of the embodiment shown in FIG. 5.

Referring to the drawings, there is shown a broiler having a tubular housing 1 which has four vertical or upright walls but has neither a top nor a bottom. On one side of the housing is mounted a vertical rod or post 2 which cooperates to provide vertical setting adjustability for a food supporting grill 3, by means of a grill handle 4 having an opening 5 therein only slightly larger than post 2. Thus, when held in a plane perpendicular to the post, the grill and grill handle may be moved up or down thereon to the desired position; and may be secured in the desired position by slightly cocking the grill and grill handle to lock the grill handle against the post. The grill handle 4 has a first portion extending vertically upwardly from the grill and a second portion extending horizontally away from the grill, forming a bent "goose neck"

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configuration which permits lowering the grill into the housing. Perfect broiling of steaks is accomplished by adjusting the grill to about ½ inch from element 15 for searing, to about 1½ inches from element 15 for cooking, and to about 3 inches from element 15 for keeping them warm prior to serving.

A removable cooking unit 6, which rests in housing 1 on a support 26, comprises a frame 12, preferably of about 12 x 16 inches, which supports all the components of unit 6. The frame 12, as shown, is of channeled configuration and has a pair of electrical insulating strips 13 disposed in the channel thereof. The frame 12 itself may, if desired, be made of an electrical insulation material. Mounted in the frame, and insulated therefrom by the insulating strips, is a pair of electric terminal pins 9 adapted to receive, through an opening 27 in the housing, a conventional electrical connector plug and cord accessory to connect the terminal pins to a conventional source of electrical energy of about 110 volts, 60 cycle, alternating current. The terminal pins 9 are connected to conductors 20 mounted in the insulating strip 13 so as to be insulated from frame 12, the conductors 20 connecting the terminal pins 9 with termnial posts 19 which are mounted in frame 12 and insulated therefrom by insulating strip 13. Connected to terminal posts 19 are the ends 21 of an electrical heating element 15, which preferably is a No. 21 Nichrome wire No. 245. Element 15 is arranged in a zig-zag fashion as shown, being supported at its points of reversal of direction by means including short fine wire links 16. The short links 16 are preferably about ⅜ inch long and are of smaller diameter stock than element 15 and preferably are of No. 23 Nichrome wire No. 245. The short links 16 are supported by L-shaped bent wire of larger diameter than either the element 15 wire or the link 16 wire, and which act as springs tensioning element 15 so as to prevent undue slack which otherwise would occur upon expansion due to heating up of element 15 upon electrical energization. End links 14 are preferably about one inch long and are mounted in the insulation in frame 12 so as to be electrically isolated. Heating element 15 preferably is arranged to have 12 or 14 crossings. With 12 crossings, the heating element 15 preferably has a total length of about 8½ feet.

Disposed in spaced relationship above element 15 is an upper protective grid 17 mounted in insulating strip 13 on frame 12 and insulated from the frame and the electric circuit. And disposed in spaced relationship below element 15 is a lower protective grid 18 mounted in insulating strip 13 on frame 12 and insulated from the frame and the electric circuit. These protective grids, in the event of breakage of element 15, confine the broken ends of the element within the grids to prevent or minimize possibility of the element touching the user, the food, the housing 1, the water tray 10 or the water 10*b* therein, and the grids being electrically isolated, will insulate a broken electric element from all parts of the broiler other than the isolated rods of the protective grids.

The grids 17 and 18 consist of a plurality of separate rods, each mounted rotatably in the frame. This feature provides easy cleaning of the rods when washing unit 6, in that when rubbed with a cloth, sponge, or other cleaning device, the rods rotate and all sides thereof are thus easily cleaned. Each rod is electrically isolated from every other rod and from all other structure of the broiler.

The electrical circuit for heating element 15 is thus seen to be, from the source of electrical energy, to one of the terminal pins 9, thence to one of terminal posts 19 via one of the conductors 20, thence through element 15 to the other of the terminal posts 19, thence via the other of the conductors 20 to the other of terminal pins 9, and back to the source of electrical energy. It is also thus seen that the electric circuit is insulated from all other parts of the broiler, and even in the event of breakage of element 15 is still insulated from the frame and housing.

In the embodiment shown in FIGS. 1–4, inclusive, all portions of the entire broiler are at temperatures outside of the smoke and flame temperature range.

Heating element 15 operates "hot," i.e., above the range, for example at over 2200 degrees F. and preferably about up to 2300 degrees F.

Each short link 16 of the fine high resistance wire, at its end in contact with element 15, becomes hot (i.e., above the range), and at its other end is cold (i.e., below the range). Only a negligible tiny spot or portion intermediate its ends is at a temperature within the range, but is so small that any fat striking it sputters off without smoking or flaming.

Terminal posts 19 may also have a small portion, at the spot where element 15 contacts the posts, that may come within the range, but it is also negligible when compared to the entire area, and is disposed at the ends where fat drippings are less likely. For complete assurance, a deflector shield or baffle, such as baffle 24, which is maintained at temperatures outside the range, may be placed above posts 19 to insure no smoking or flaming, as is illustrated in FIGS. 5 and 6.

All of the other components of the broiler are spaced sufficiently from element 15 so as to be cold (i.e., below the range).

Upper protective grid 17 is about ¼ inch from element 15. Lower protective grid 18 is about ¾ inch from element 15. Short links 16 are about ⅜ inch in length thus spacing end links 14 that distance from element 15. The remaining components are even further from element 15 than those just mentioned and thus are "cold," i.e., below the range, and thus smokeless and flameless.

Mounted near the lower end of housing 1 is a removable fat drippings-and-water tray 10 slidably removable therefrom easily by a pull fixture 10*a*. The water tray may contain water in the bottom thereof as is indicated by reference numeral 10*b*. Fat dripping from the food drops into the water in tray 10 so that, after cooking, the fat may be easily poured out and the tray easily cleaned. For cooking very fatty foods, the presence of water is highly desirable. The tray is disposed close to the heating element 15 for efficiency and economics of space, but not so close as to cause fats in the tray to smoke or ignite. The correct distance has been found to be approximately 4½ inches from heating element 15 to the bottom of tray 10.

Housing 1 is provided with a plurality of openings 11, vertically in alignment, to provide vertical adjustability for mounting a support for a rotissiere or rotating spit, to adjustably dispose the rotating shaft of the rotissiere above the unit 6. In this arrangement, one may conveniently cook birds, or other food to be rotated, over unit 6, and may vary the size of the bird or other food, and still keep the surface of the food at the desired distance from the heating element 15.

The frame 12 is of such size, and construction so that the removable unit 6 fits easily within water tray 10. This provides the convenient utility, when done cooking, of being able to wash unit 6 in water tray 10, by submersing unit 6 in water in tray 10.

Grill 3 is also of such size and construction so that it also fits easily within water tray 10 for such convenient washing. The upwardly bent "goose-neck" grill handle 4 of the grill permits the grill to be placed in the water tray, just as it permits the grill to be placed in the housing 1.

FIGS. 5 and 6 illustrate another embodiment of the invention wherein a heating element 22 is "hot" (i.e., is at a temperature above the smoke and flame temperature range), but wherein the support 23 for element 22, and perhaps a small portion of the end of element 22, is "intermediate" (i.e., within the smoke and flame temperature

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range). Thus, if fats were to drip on the support 23, smoking and/or flaming would result. To eliminate smoking and flaming, there is provided a deflector shield or baffle 24 which is either "hot" or "cold" (i.e., is outside of the smoke and flame temperature range). Fats will thus hit baffle 24 and not smoke or flame, and the fats are deflected from support 23. The baffle 24 may be a cold member (i.e., below the range), or may be a hot member (i.e., an element heated so as to be above the range). Element 22 may be, for example, a Globar heating element, which operates at temperatures above the range, e.g., at about 2300 degrees F., but which is usually mounted in such a way so that the end support member and a small portion of the end of the element is within the range. Element 22 could alternatively be No. 21 Nichrome wire No. 245 such as hereinbefore described for element 15, but mounted in such a way that the mounting and perhaps a small portion of the element are within the range.

Applicant has thus provided a novel broiling means and method for broiling smoke-free and flame-free, by providing, in the first embodiment, a hot heating element, and all other components cold. In the second embodiment applicant provides a hot heating element, cold components, and intermediate components, wherein the intermediate components are shielded from fats by either a hot or a cold baffle means.

Having thus described the invention, what is claimed as new and desired to be secured by Letters Patent, is:

1. A broiler comprising, support means operating below the smoke and flame temperature range adapted to be supported on a supporting surface, a food supporting grill on said support means, a heating element arranged below said supporting grill, intermediate means for supporting said heating element on said support means, said heating element having surfaces exposed to the path of fats falling from food supported on said grill operating above the smoke and flame temperature range and spaces between said surfaces through which fats fall, means for supporting said grill a distance above said heating element so that the temperature of the grill as heated by the heating element is below the smoke and flame temperature range, said heating element being spaced a sufficient distance above a surface on to which the fats fall so that said surface as heated by the heating element operates below the smoke and flame temperature range, the area of said intermediate supporting means upon which fats may fall being such a small portion of the entire area below the grill through which the fats fall that any smoke or flame produced by fats falling on the intermediate supporting means is negligible.

2. A method of broiling foods comprising, the steps of, placing food on a grill positioned above a heating element having surfaces exposed to the path of fats falling from said food and spaces therebetween through which fats fall, operating said surfaces above the smoke and flame temperature range, providing support means operating below the smoke and flame temperature range for said grill, providing intermediate means for supporting the heating element on said support means, spacing said grill a sufficient distance above the heating element to maintain the temperature of the grill as heated by the heating element below the smoke and flame temperature range, spacing said heating element a sufficient distance above a lower surface on to which said fats fall so that said lower surface as heated by the heating element operates below the smoke and flame temperature range, and confining said intermediate supporting means in such a small portion of the entire area below the grill through which fats fall that any smoke or flame produced by fats impinging on the intermediate supporting means is negligible.

3. A broiler comprising, support means operating below the smoke and flame temperature range adapted to be supported on a supporting surface, a food supporting grill on said support means, a heating element arranged below said supporting grill, intermediate means for supporting said heating element on said support means, said heating element having surfaces exposed to the path of fats falling from food supported on said grill operating above the smoke and flame temperature range and spaces between said surfaces through which fats fall, means for supporting said grill a distance above said heating element so that the temperature of the grill as heated by the heating element is below the smoke and flame temperature range, a fat collecting pan spaced a sufficient distance below said heating element so that said pan into which fats fall as heated by said heating element operates below the smoke and flame temperature range, said pan having water therein for facilitating the removal of fats therefrom, the area of said intermediate supporting means upon which fats may fall being such a small portion of the entire area below the grill through which the fats fall that any smoke or flame produced by fats falling on the intermediate supporting means is negligible.

4. A broiler comprising, support means operating below the smoke and flame temperature range adapted to be supported on a supporting surface, a food supporting grill on said support means, an electrically operated heating element arranged below said supporting grill, intermediate means for supporting said heating element on said support means, said heating element having surfaces exposed to the path of fats falling from food supported on said grill operating above the smoke and flame temperature range and spaces between said surfaces through which fats fall, means for supporting said grill a distance above said heating element so that the temperature of the grill as heated by the heating element is below the smoke and flame temperature range, said heating element being spaced a sufficient distance above a surface on to which the fats fall so that said surface as heated by the heating element operates below the smoke and flame temperature range; the area of said intermediate supporting means upon which fats may fall being such a small portion of the entire area below the grill through which the fats fall that any smoke or flame produced by fats falling on the intermediate supporting means is negligible.

5. A broiler comprising, support means operating below the smoke and flame temperature range adapted to be supported on a supporting surface, a food supporting grill on said support means, a heating element arranged below said supporting grill, intermediate means for supporting said heating element on said support means, said heating element having surfaces exposed to the path of fats falling from food supported on said grill operating above the smoke and flame temperature range and spaces between said surfaces through which fats fall, means for supporting said grill a distance above said heating element so that the temperature of the grill as heated by the heating element is below the smoke and flame temperature range, said heating element being spaced sufficient distance above a surface on to which the fats fall so that said surface as heated by the heating element operates below the smoke and flame temperature range, and means operating outside of the smoke and flame temperature range for shielding said intermediate supporting means against falling fats.

6. A broiler comprising, support means operating below the smoke and flame temperature range adapted to be supported on a supporting surface, a food supporting grill on said support means, a heating element arranged below said supporting grill, intermediate means for supporting said heating element on said support means, said intermediate supporting means being located a sufficient distance from the area in which fats normally fall so that any smoke or flame produced by fats falling thereon is negligible, said heating element having surfaces exposed to the path of fats falling from food supported on said grill operating above the smoke and flame tempera-

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ture range and spaces between said surfaces through which fats fall, and means for supporting said grill a distance above said heating element so that the temperature of the grill as heated by the heating element is below the smoke and flame temperature range, said heating element being spaced a sufficient distance above a surface on to which the fats fall so that said surface as heated by the heating element operates below the smoke and flame temperature range.

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8

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ROBERT E. PULFREY, *Primary Examiner.*

GEORGE A. NINAS, JR., A. H. WILKELSTEIN, A. LEWIS MONACELL, JEROME SCHNALL,
Examiners.

APPENDIX G

SUBSCRIPTION AGREEMENT

We, the undersigned, hereby subscribe for and agree to take and pay for the number of shares of the capital stock of the SHOUP ENGINEERING CORP. set opposite our respective names and post office addresses, and pay therefor the sum of money set opposite our names, or by assigning all right, title and interest in the personall property set opposite our names to said corporation.

NAME	P. O. ADDRESS	NO. OF SHARES	AMOUNT
Myron Haack	1309 Hawthorne Janesville, Wisconsin	1,000	$1,000.00
E. G Anderson M. D	Janesville, Wisconsin	1,000	$1,000.00
Marian Waite	12221 Eggleston Chicago, Illinois	10,000	$10,000.00
Allen A. Shoup	1309 Hawthorne Janesville, Wisconsin	88,000	All right, title and interest in the design, patent, labor and material and any other right in a smokeless electric broiler, Broilitizer by trade name and general recognition.

Dated March 14, 1961 At New Berlin, Wisconsin

Allen A. Shoup

Myron Haack

E. G Anderson

Marian Waite

APPENDIX H

ASSIGNMENT

For value received, now and in the future, the SHOUP ENGINEERING CORPORATION, a Wisconsin Corporation, hereby assigns all rights, titles and interest, except for a previous assignment for Five Thousand ($5000.00) Dollars in patent application 88 868 filed February 13, 1961, to the IRENE SCHNEIDER TRUST.

Also assigned is all rights, title and interests created by an agreement with McGraw-Edison Company dated October 30, 1962, which is a royalty agreement covering the above patent.

DATED October 25th, 1963.

WITNESSED BY:

Robert D. Read
ROBERT D. READ

Leota M. Frame
LEOTA M. FRAME

SHOUP ENGINEERING CORPORATION

By: Allen A. Shoup
Allen A. Shoup, President

Subscribed and sworn to before me this 25th day of October, 1963.

Robert D. Read
ROBERT D. READ
Notary Public, Walworth County, Wisconsin

My commission is permanent.

STATE OF WISCONSIN)
)
WALWORTH COUNTY)

I, Lois M. Ketterhagen, Register of Deeds of said County do hereby certify that the copy hereunto annexed has been compared by me with the original record of Assignment, Shoup Engineering Corp. to Irene Schneider Trust, recorded in Vol. 608 Pages 49-50 of Deeds, Walworth County Records

Now on record in my office and required by law to be in my custody and in my office, and that said copy is a true copy of said record and the whole thereof.

IN TESTIMONY WHEREOF, I have hereunto set my hand and affixed the seal of the Walworth County Register of Deeds at the City of Elkhorn, in the said County, this 24th day of September 1973.

Lois M. Ketterhagen

Lois M. Ketterhagen and.
Register of Deeds

5-61954

REGISTERS OFFICE } ss
Walworth Co., Wis. }

Received for record this 31 day of July A.D. 1964 at 8:25 o'clock A.M. and Recorded in Vol. 609 of Deeds on page 49

Eleanor A. Wickstrom
REGISTER OF DEEDS

8:45

Henry & Bruder
Title Service

1:50 PM

APPENDIX I

A S S I G N M E N T

For and in consideration of One Dollar ($1.00) to me in hand paid, and other valuable consideration, the receipt and sufficiency whereof are hereby acknowledged and confessed, I, Allen A. Shoup, of 1632 Lake Shore Drive, Lake Geneva, Wisconsin, warrant that I am the sole inventor and the sole and exclusive owner of application for United States Letters Patent Serial Number 88,868, filed February 13, 1961 and the invention disclosed therein, and I hereby sell, assign, transfer and set over unto Shoup Engineering Corporation, a Wisconsin corporation, having an office and place of business in East Troy, Wisconsin, nunc pro tunc as of March 14, 1961, pursuant to a subscription agreement executed on that date, the entire right, title and interest in and to said application and invention, together with all other rights pertaining to said application and invention.

IN WITNESS WHEREOF, I have hereunto subscribed my name at Chicago, Illinois, this 21st day of January, 1965.

Allen A. Shoup

STATE OF ILLINOIS }
COUNTY OF COOK } ss.

Subscribed and sworn to before me this 21st day of January, 1965.

Notary Public

(SEAL)

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APPENDIX J

A S S I G N M E N T

WHEREAS, IRENE SCHNEIDER TRUST, a trust created under the laws of the State of Wisconsin, hereinafter called the "ASSIGNOR", is the owner of the entire right, title and interest in and to United States Letters Patent 3,174,863, granted March 23, 1965, and the invention disclosed therein.

WHEREAS, MARIAN SHOUP, of Chicago, Illinois, hereinafter called the "ASSIGNEE", is desirous of acquiring the entire right, title and interest in and to said United States Letters Patent and the invention disclosed therein, as hereinafter more fully set forth.

NOW, THEREFORE, TO ALL WHOM IT MAY CONCERN, Be it known that for and in consideration of the sum of Ten Dollars ($10.00), and other valuable and legally sufficient considerations, the receipt of which by the said ASSIGNOR from the said ASSIGNEE is hereby acknowledged, the said ASSIGNOR has sold, assigned and transferred, and by these presents does sell, assign and transfer unto the said ASSIGNEE the entire right, title and interest in and to the United States Letters Patent and the invention disclosed therein, to have and to hold for the sole and exclusive use and benefit of the said ASSIGNEE, to the full end of the term or terms for which said Letters Patent issued.

For the same consideration, the ASSIGNOR has sold, assigned and transferred, and by these presents does sell, assign and transfer unto said ASSIGNEE all the rights and

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benefits accrued or accruing to the ASSIGNOR under said United States Letters Patent and the invention disclosed therein; and the right to sue for all past, present, and future infringements thereof and for all damages, or loss of profits sustained by reason of such infringement; and this Assignment includes all royalties which may be due, whether accrued or to accrue or to be paid in the future, as well as all licenses under which the ASSIGNOR has been or may be operating with respect to said inventions and patents.

The ASSIGNOR further agrees that it will execute and deliver to the ASSIGNEE any and all additional papers which may be requested by the said ASSIGNEE to fully carry out the terms of this Assignment, and that this Assignment conveys to the ASSIGNEE all the right, title and interest as fully and entirely as the same would have been held by the ASSIGNOR had this Assignment and sale not been made.

IN WITNESS WHEREOF, the said ASSIGNOR has caused this instrument to be executed this 3rd day of August 1968.

IRENE SCHNEIDER TRUST

Marian Shoup

Marian Shoup, Trustee

Robert D. Read

Robert D. Read, Administrator

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STATE OF WISCONSIN)
) SS
COUNTY OF Oneida)

On this 31 day of August, 1968, MARIAN SHOUP and ROBERT D. READ, both personally known to me to be the persons whose names are subscribed to the foregoing instrument, personally appeared before me, and by me being duly sworn, did each depose and say that they are Trustee and Administrator, respectively, of the above-mentioned IRENE SCHNEIDER TRUST, a trust created under the laws of the State of Wisconsin; and they severally acknowledged that they signed, sealed, and delivered the said instrument as their free and voluntary act and the free and voluntary act and deed of said Trust.

Notary Public

(SEAL)

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SUPREME COURT, U. S.

Supreme Court, U. S.
FILED
APR 21 1976
MICHAEL RODAK, JR., CLERK

No. 75-1405

In the
Supreme Court of the United States
October Term, 1975

MARSHALL FIELD & CO.,
Petitioner,

vs.

MARIAN SHOUP,
Respondent.

BRIEF OF RESPONDENT IN OPPOSITION

Lloyd L. Zickert
One First National Plaza
Chicago, Illinois 60603
Attorney for Respondent

The Scheffer Press, Inc.—(312) 263-6850

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In The

SUPREME COURT OF THE UNITED STATES

October Term, 1975

No. 75-1405

MARSHALL FIELD & CO.,

Petitioner,

vs.

MARIAN SHOUP,

Respondent.

BRIEF OF RESPONDENT IN OPPOSITION

Respondent submits that a writ of certiorari should not be issued for the purpose of reviewing the U. S. Court of Appeals for the Seventh Circuit decision dated March 1, 1976 in its case No. 75-1729..

QUESTION PRESENTED

Whether the factual evidence submitted on the issue of title and considered by the District Court and the Court of Appeals supports the finding of the District Court and adopted by the Court of Appeals that Respondent Marian Shoup is the owner of the patent in suit.

STATEMENT OF THE CASE

Because of inaccuracies, errors and omissions contained in the Petitioner's Statement, the following presentation of facts material to the title issue is presented together with remarks concerning the statement in the Petition.

It is apparent the presentation of facts in the Petition in a fashion contrary to the evidence and findings of the lower court is misleading and confusing. The thrust of the Petition is based upon an assertion that a false notation of title is printed on the patent through a mistake of an unidentified clerk in the Patent Office. Yet, the courts below, after considering the evidence submitted, did not agree with this thrust.

The patent in suit 3,174,863 (P. App. F)* was granted to the Irene Schneider Trust. Thereafter, the patent was assigned to Respondent Marian Shoup.

Ownership of the patent by Respondent Marian Shoup is evidenced by documents recorded in the U.S. Patent Office which include an assignment (P. App. I) from the inventor Allen A. Shoup to Shoup Engineering Corporation, an assignment (P. App. H) from the Shoup Engineering Corporation to the Irene Schneider Trust, and an assignment (P. App. J) from the Irene Schneider Trust to Respondent. The U.S. Patent Office certified the recording of these documents in the digest issued March 19, 1974 (R. App. K).** These instruments were examined and considered by the District Court and the Court of Appeals *prior* to the finding that Respondent is the owner of the patent in suit.

---

* P. App. = Appendix to Petition for Writ of Certiorari

** R. App. = Appendix to Brief of Respondent in Opposition

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Additionally, the subscription agreement dated March 14, 1961 (P. App. G), an affidavit of Respondent Marian Shoup dated July 3, 1974 (R. App. L), the corporate charter of Shoup Engineering Corporation (R. App. M), oral testimony of Robert C. Read and Berwyn B. Braden at the title hearing, and other evidence were considered by the District Court and the Court of Appeals in connection with deciding the issue of title.

In the deposition of Respondent Marian Shoup taken on September 26, 1973, she responded to counsel for Petitioner:

> "Q. Who is the present owner of Patent No. 3,174,863? Maybe you will want to look at it.
> "A. (Examining document) I am."

At the title hearing Mr. Read testified:

> "Q. Do you know of any other party who held an interest in the patent or any part or any legal title to the patent prior to or subsequent to the assignment from the Shoup Engineering Corporation to the trust?
> "A. No, I know of none."

and Mr. Braden testified:

> "Q. Do you know of any other party during the time that you have been acquainted with this matter that has stated that they own any title in this patent or in the invention?
> "A. I know of no one."

Relative to the purpose of the nunc pro tunc assignment (P. App. I), Mr. Braden testified:

> "The Witness: Yes, your Honor, I have an explanation for that:

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"This assignment dated 1965 is nunc pro tunc, March 14, 1961, which is the date of the subscription agreement that I just referred to, and I understand that this assignment was drawn in 1965 in recordable form that would be acceptable for recording purposes in the United States Patent Office."

Concerning the provision in the assignment to the Irene Schneider Trust, Mr. Read testified:

"Q. Mr. Shoup told you that there was a previous assignment for $5000 in the patent application; that is the source of your statement there in that document?

"A. Yes, right. There was no actual assignment.

"Q. Do you know that of your own knowledge?

"A. Yes, I know Mr. Shoup told me that, yes."

The various assignment documents conform to the provisions of 35 USC 261, and the granting of the patent to the Irene Schneider Trust conforms to 35 USC 152

The manufacturers of the Toastmaster broiler, the Farberware broiler and the Cory broiler were licensed under the Shoup patent and recognized Respondent as the owner of the patent (P. App. C, Findings of Fact 5, 47, 48, 49, 50 and 51).

It is incorrect that Petitioner contends the notation printed in the heading of the Shoup patent to be false as such is not supported by the record.

It is incorrect that Petitioner in its Satement contends Shoup Engineering Corporation to be the owner of the patent or possibly to have assigned the patent to some unknown person or firm as no evidence of this contention is in the record.

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It is further incorrect for Petitioner to state the subscription agreement (P. App. G) did not operate as an assignment of the invention to Shoup Engineering Corporation wherein the body of this agreement clearly indicates the subscribers not only treated the corporation as being in existence on the date of the agreement for the purposes of the transactions described but also entered the agreement on the basis the invention of Allen Shoup be assigned to the corporation. Indeed, the subsequent nunc pro tunc assignment (P. App. I) confirmed the intention of the inventor that the invention was assigned to the corporation on the date of the subscription agreement. Respondent Marian Shoup also considered the transfer effective as of this date as indicated in her affidavit (R. App. L). The statute 35 USC 261 does not preclude the operativeness of this subscription agreement but does state a verified instrument such as the nunc pro tunc document to be prima facie evidence of execution.

It is incorrect that Petitioner's Statement asserts the assignment of October 25, 1963 from Shoup Engineering Corporation to the Irene Schneider Trust did not transfer all rights in the invention. The evidence submitted clearly controverts this assertion. See testimony of Messrs. Read and Braden supra. Petitioner did not submit any evidence contrary to the testimony of Messrs. Read and Braden.

It is incorrect for Petitioner to suggest in its statement that the transaction set forth in the subscription agreement did not take place. It is a matter of public record Shoup Engineering Corporation was formed on February 17, 1961 (R. App. M), nearly one month prior to the subscription agreement. After formation, members of a corporation can legally conduct business among themselves such as was conducted on March 14, 1961 per the subscription agreement.

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In view of the evidence considered by the courts, it is incorrect for Petitioner to assert the courts below abdicated their judicial determination of title to some unknown clerk or to assert that the courts relied solely on the notation of the title in the heading of the patent. In the finding of fact No. 3 in the District Court's Findings (P. App. C), Respondent was found to have the entire right, title and interest in the patent in suit and in Conclusion of Law No. 2, Respondent was declared the owner of the Shoup patent.

It is incorrect for Petitioner to suggest the Patent Office personnel were confused by the recording of the assignment from Allen A. Shoup to Shoup Engineering Corporation and the assignment from Shoup Engineering Corporation to the Irene Schneider Trust on the same day. The order of these assignments is correctly set forth in the certified copy of the digest prepared by the Patent Office (R. App. L).

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REASONS FOR DENYING THE WRIT

1. The question presented here is one of fact and was correctly decided by the District Court and by the Court of Appeals.

As above noted, it is abundantly clear from the three questions presented in the Petition that the thrust of the Petition attacks a question of fact decided below concerning the notation of title printed at the heading of the patent. Petitioner claims this notation is false because it is the result of a mistake of a clerk in the Patent Office.

Prior to the title hearing, Petitioner moved for summary judgment on the ground Respondent did not own the patent in suit. This motion was denied in the Memorandum Opinion and Order dated June 7, 1974 (R. App. N) on the basis a crucial material fact was in dispute. Thereafter, pursuant to evidence submitted *only* by Respondent at the title hearing on July 11, 1974 (no evidence was submitted by Petitioner), the District Court resolved this crucial material fact and found Respondent to have complete title in the patent, as set forth in the Memorandum Opinion and Order dated October 15, 1974 (P. App. B). Petitioner's subsequent motion for reconsideration of the Court's memorandum was denied by the Court's minute order of November 19, 1974 (R. App. O). The Court of Appeals adopted the District Court's memorandum of October 15, 1974.

Accordingly, the District Court and the Court of Appeals relied upon the evidence submitted at the title hearing in effectively concluding the fact that the notation of title at the heading of the patent was correct and in accordance with the assignment documents recorded in

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the Patent Office and in accordance with other documents relating to title.

2. The District Court and the Court of Appeals correctly interpreted the statutory and decisional law applicable to the title issue.

Petitioner does not contest the fact that the assignments recorded in the Patent Office prior to the issuance of the patent in suit are authentic and that the assignments were considered by the District Court in determining title did reside in the Irene Schneider Trust the date of the patent in suit was granted.

The very early Supreme Court case of *Gayler* v. *Wilder,* 10 How. 477 (1850), established the widely followed rule that legal title to a patent is in the assignee where an assignment is recorded before a patent issues. The further widely followed rule that a named assignee in an issued patent is prima facie evidence title resides in such assignee was laid down by the District Court of Massachusetts in *Beckwith Box Tow Co.* v. *Gowdy,* 244 Fed. 805 (1916). Indeed, if it is true that a Patent Office clerk determined the content of the notation in the heading in the patent in suit, that clerk clearly followed these decisions.

The District Court further followed other established decision law on title. *Consolidated Electric Co.* v. *Edison Electric Light Co.,* 25 Fed. 719 (C.C. N.Y., 1885) clearly establishes title to be vested in the ultimate assignee where successive assignments are recorded in the U.S. Patent Office prior to issuance of a patent. Moreover, *Elliot-Fisher Co.* v. *Underwood Typewriter Co.,* 176 Fed. 372 (C.C. S.D. N.Y., 1909), states:

> "I find no authority for the proposition that patents may not be issued to an assignee, who holds through mesne assignements from the inventor, provided such assignments are first entered of record in the Patent Office."

There can be no question that the Irene Schneider Trust was the last assignee recorded in the U.S. Patent Office prior to the issuance of the Shoup patent.

Further, there is no question that the Respondent is now the last named assignee in the chain of title as recorded in the U.S. Patent Office for the patent in suit as per the title report.

The Court of Appeals recognized only established rules of law were applied by the District Court in labeling its decision as an unpublished order.

3. The reasons advanced by Petitioner for granting the Writ are unsound and unsupported by the record.

There is no quarrel with the premise that Petitioner is entitled to be sued for infringement by the owner of title to the patent and such was so held by the District Court in its Memorandum Opinion and Order dated October 15, 1974 (P. App. B, page 28, lines 22-24). Respondent was properly determined to be the owner. Accordingly, there is no basis for Peitioner's assertion that it will be left vulnerable to another suit.

The fabrication in reasons 2 and 3 (pages 16-19 of the Petition) that some Patent Office clerk determined the issue of title based upon assignment instruments presented for recording, whether right or wrong, is immaterial since the courts below did not rely on any such determination.

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The further suggestion that the decision rendered on the title issue by the District Court and adopted by the Court of Appeals is in conflict with *De Sylva* v. *Ballentine* and *Bartok* v. *Boosey & Hawks, Inc.* is incorrect. There can be no conflict with these decisions which concern the interpretation of an application of the copyright renewal statute. *De Sylvia* interprets the renewal statute in connection with rights of a widow and child where the author is dead, while *Bartok* deals with the question of whether a musical composition was posthumous.

CONCLUSION

The evidence considered by the District Court and examined by the Court of Appeals leaves no room for doubt that Respondent Marian Shoup is the owner of the patent in suit.

The adjudication of patent ownership by the District Court and the Court of Appeals of the Seventh Circuit is not in conflict with decisions of this Court and other circuits.

There is no sound basis on which this Court should review the decisions below.

Accordingly, the Petition of Marshall Field & Co. for writ of certiorari should be denied.

Respectfully submitted,

LLOYD L. ZICKERT
One First National Plaza
Chicago, Illinois 60603
Attorney for Respondent

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APPENDIX K

APPENDIX K
U.S. DEPARTMENT OF COMMERCE
PATENT OFFICE
WASHINGTON, D.C. 20231

March 19, 1974
(Date)

This is to certify, That the annexed is a true copy from the Digest of the Assignment Records of all documents found of record up to and including February 20, 1974, referring to Patent Number 3,174,863, Issued March 23, 1965.

By authority of the
COMMISSIONER OF PATENTS
Emmanuel J. Remline
Certifying Officer

FORM PO-85 (8-70)

USCOMM-DC 61276-P70

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INVENTOR	Shoup, Allen A.
ASSIGNOR	Same
ASSIGNEE	Shoup Engineering Corporation, East Troy, Wis., a Wis. corp.
TITLE	TITLE OF INVENTION NOT STATED
BRIEF	Assigns, as of Mar. 14, 1961, the entire interest

DOCUMENT DATED	APPLICATION EXECUTED	DOCKET NO
Jan. 21, 1965 Ack.		

RECORDED	REEL	FRAME	APPLICATION FILED	SERIAL NO	PATENT NO	PATENT DATE
1-22-65	1488	300	2-13-61	88,868	3,174,863	3-23-65

INVENTOR	Shoup, Allen A.
ASSIGNOR	Shoup Engineering Corporation, a Wis. corp.
ASSIGNEE	Schneider, Irene, Trust
TITLE	TITLE OF INVENTION NOT STATED
BRIEF	Assigns the entire interest in said patent and in the Agreement with McGraw-Edison Company dated Oct. 30, 1962. (See Record for details.)

DOCUMENT DATED	APPLICATION EXECUTED	DOCKET NO
Oct. 25, 1963 Ack.		

RECORDED	REEL	FRAME	APPLICATION FILED	SERIAL NO	PATENT NO	PATENT DATE
1-22-65	1488	299	2-13-61	88,868	3,174,863	3-23-65

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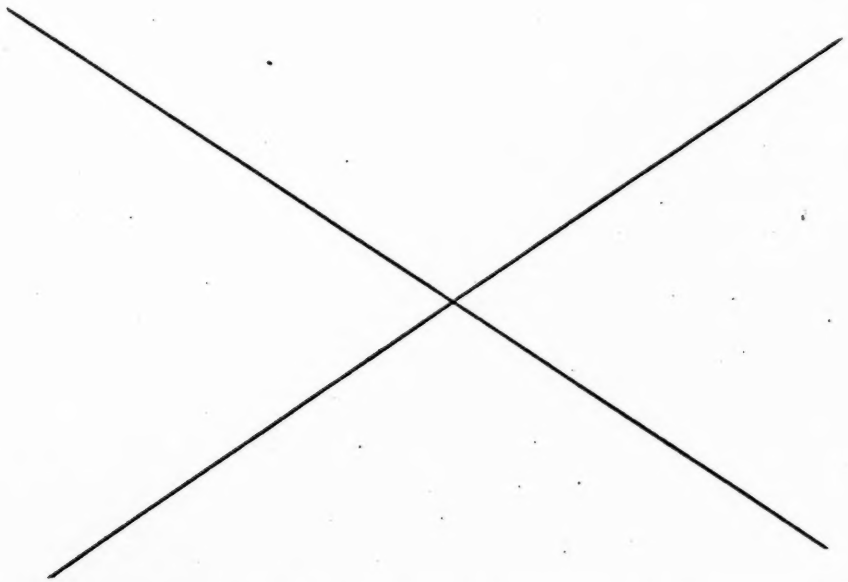
INVENTOR	Shoup, Allen A.
ASSIGNOR	Schneider, Irene Trust, a Wisconsin Trust
ASSIGNEE	Shoup, Marian Chicago, Ill.
TITLE	TITLE OF INVENTION NOT STATED
BRIEF	Assigns the entire interest

DOCUMENT DATED				APPLICATION EXECUTED		DOCKET NO.
8-3-68 Ack.						
RECORDED	REEL	FRAME	APPLICATION FILED	SERIAL NO.	PATENT NO.	PATENT DATE
8-12-68	2394	566			3,174,863	3-23-65



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APPENDIX L

IN THE UNITED STATES DISTRICT COURT

For The Northern District of Illinois

Eastern Division

MARIAN SHOUP,

Plaintiff,

v.

MARSHALL FIELD & Co.,

Defendant.

Civil Action No. 69 C 1682

AFFIDAVIT OF MARIAN SHOUP

STATE OF CALIFORNIA)
) SS.
COUNTY OF)

MARIAN SHOUP, being duly sworn, deposes and says:

1. She is the same person as the named plaintiff in the above identified action.

2. She is the widow of Allen A. Shoup.

3. Said Allen A. Shoup is the named inventor in U. S. Patent 3,174,863.

4. Prior to her marriage to Allen A. Shoup, her name was Marian Waite; and she is the same person who signed as "Marian Waite" on the subscription agreement dated March 14, 1961, a copy attached as Exhibit A.

5. She is familiar with the invention disclosed and claimed in the Shoup Patent 3,174,863; and it was her understanding on March 14, 1961 that this invention was assigned to Shoup Engineering Corp. by the inventor Allen A. Shoup in return for 88,000 shares of Shoup

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Engineering Corp., pursuant to said subscription agreement.

6. She was the Trustee of the Irene Schneider Trust.

7. She retained Mr. Berwyn B. Braden of Lake Geneva, Wisconsin, as counsel for said Irene Schneider Trust to represent the Trust in litigation in the Walworth County Circuit Court in Wisconsin which resulted in a judgment dated November 26, 1968 nunc pro tunc, November 6, 1968, a copy attached as Exhibit B.

8. As Trustee of the Irene Schneider Trust, she executed the assignment dated August 3, 1968, a copy attached as Exhibit C; and she is the same person named as "ASSIGNEE" in said assignment.

9. She is familiar with the assignment document dated October 25, 1963, a copy attached as Exhibit D, and since this assignment she is not aware of any person heretofore or at the present claiming any title to the patent in suit or the patent application preceding the patent other than the Irene Schneider Trust.

10. Since August 3, 1968, she knows of no person claiming any ownership to the patent in suit other than herself.

11. A copy of said Patent 3,174,863 is attached as Exhibit E.

/s/ Marian Shoup
Marian Shoup

Subscribed and sworn to before me this 3rd day of July, 1974.

/s/ Lillian Aranda
Lillian Aranda
Notary Public

(Seal)

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APPENDIX M

Form 2—Gen. Stats.
Certificate of Incorporation

APPENDIX M

United States of America
State of Wisconsin
Department of State

S-10824

To All to Whom These Presents Shall Come:

The undersigned, as Secretary of State of the State of Wisconsin, hereby certifies that, on the 17th *day of* February *,19*61*, Articles of Incorporation were filed in my office, and the filing fee paid, under the provisions of Chapter 180 of the Wisconsin Statutes, which Articles provide:*

Name: SHOUP ENGINEERING CORP.

Registered Office: 1309 Hawthorne Street, Janesville, Wisconsin.

Period of Existence: Perpetual

Capital Stock: 100,000 shares of common stock at $1 per share.

Purposes for which organized: to engage in any lawful purpose authorized by Chapter 180 of the Wisconsin Statutes.

I further certify that a certificate has been filed in my office to the effect that a duplicate of said Articles, bearing my certificate, was recorded in the office of the Register of Deeds of Rock *County, Wisconsin, on the* 3rd *day of* April *,19*61*.*

THEREFORE, The State of Wisconsin does hereby grant unto the said corporation the powers and privileges conferred by the Wisconsin Statutes for the purposes stated and in accordance with said Articles.

In Witness Whereof, I have hereunto set my hand and affixed my official seal, at the Capitol, in the City of Madison, this 12th *day of* April *A. D. 19*61*.*

ROBERT C. ZIMMERMAN
Secretary of State

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APPENDIX N

IN THE UNITED STATES DISTRICT COURT

For The Northern District of Illinois

Eastern Division

MARIAN SHOUP,

Plaintiff,

v.

MARSHALL FIELD & Co.,

Defendant.

Civil Action No. 69 C 1682

MEMORANDUM OPINION AND ORDER

This is a civil action brought by Marian Shoup for the alleged infringement of a patent on a smokeless broiler by the defendant Marshall Field & Company. Even though this case was filed almost four years ago, the defendant has now moved for summary judgment on the thresold issue of patent ownership, claiming that the plaintiff does not possess sufficient title in the patent to maintain this suit.

In order to grant a motion for summary judgment, this Court must be convinced that there exists ". . . no genuine issue as to any material fact and that the moving party is entitled to a judgment as a matter of law. . . ." F.R.C.P. Rule 56(c). Furthermore, when determining whether a material issue of fact exists in the present controversy, this Court must look at the record in the light most favorable to the party opposing the motion. *Poller* v. *Columbia Broadcasting System, Inc.*, 368 U.S. 464 (1961). All inferences must be construed in favor of the motion's opponent. *United States* v. *Diebold, Inc.*,

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369 U.S. 654 (1962); *2361 State Corporation* v. *Sealy, Inc.*, 263 F.Supp. 845 (N.D.Ill. 1967). Thus, even if it can ". . . be surmised that the party against whom the motion is made is unlikely to prevail at the trial [this] is not sufficient to authorize summary judgment against him." *National Screen Service Corporation* v. *The Poster Exchange, Inc.*, 305 F.2d 647 (5th Cir. 1962).

In the situation presented by the instant controversy, the plaintiff claims full and complete title to the patent while the defendant claims that the plaintiff's title is less than complete. Thus there exists a substantial dispute as to a crucial material fact underlying this case and, as such, it cannot be decided by a motion of this type.

For this reason, the defendant's motion for summary judgment is hereby denied.

ENTER:

/s/ Frank J. McGarr
United States District Judge

Dated: June 7, 1974

APPENDIX O

UNITED STATES DISTRICT COURT

Northern District of Illinois

Eastern Division

Name of Presiding Judge, Honorable Frank J. McGarr

Cause No. 69 C 1682 Date 11/19/74

Title of Cause Marian Shoup v. Marshall Field & Co.

Brief Statement of Motion —

Names and Addresses of moving counsel —

Representing —

Names and Addresses of other counsel entitled to notice and names of parties they represent —

Notes — Motion of defendant for reconsideration of the Court's memorandum or, in the alternative, for an order amending the memorandum opinion and order dated October 15, 1974, to permit immediate right of appeals, is hereby denied.

/s/ Frank J. McGarr
Judge

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SUPREME COURT, U. S.
Supreme Court, U. S.
FILED
MAY 6 1976
MICHAEL RODAK, JR., CLERK

Supreme Court of the United States

October Term, 1975
No. 75-1405

MARSHALL FIELD & CO.,
Petitioner,

vs.

MARIAN SHOUP,
Respondent.

REPLY BRIEF OF PETITIONER

BRUCE B. KROST
WOODLING, KROST, GRANGER & RUST
655 Union Commerce Building
Cleveland, Ohio 44115

DALLETT HOOPES
c/o Scovill Manufacturing Company
Scovill Square
Waterbury, Conn. 06720

CLARENCE J. FLEMING
McDOUGALL, HERSH & SCOTT
135 S. LaSalle St.
Chicago, Illinois 60603
Counsel for Petitioner

THE GATES LEGAL PUBLISHING CO., CLEVELAND, OHIO—TEL. (216) 621-5647

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Supreme Court of the United States

October Term, 1975
No. 75-1405

MARSHALL FIELD & CO.,
Petitioner,
vs.
MARIAN SHOUP,
Respondent.

REPLY BRIEF OF PETITIONER

In response to matters presented in the Brief of Respondent In Opposition, the Petitioner says:

1. Basis of the Judgments Below.

The decision of the Courts below was based *solely* upon the erroneous statement noted at the head of the Shoup patent in suit.

The District Court disregarded all other evidence, including the written assignment instruments which show title to be in the Shoup Engineering Corporation, and referring to this erroneous statement noted on the patent, said in its Opinion and Order of October 15, 1974 (Appendix B to Petition):

> "The Court accepts *this statement on the face of the patent* as prima facie evidence of ownership at that date".

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The Court of Appeals *adopted,* and based its affirmation upon, this *same* ruling on title which was expressly premised on the erroneous statement noted on the patent, as disclosed in the Court of Appeals in its affirming decision of March 1, 1976 (Appendix A-1 to Petition), by its statement:

> "We *approve and adopt* the initial memorandum decision of the trial court on *this issue*. Shoup v. Marshall Field & Co.,* N.D. Ill., ___ F. Supp. ..... (October 15, 1974)."
>
> (*"this issue" being the issue of title).

2. Supplemental Items Advanced by Respondent to Cure the Defect in Title.

Notwithstanding the rulings below being expressly *premised upon the false statement of title* noted on the face of the patent (rather than upon the written assignment instruments showing title to be in the Shoup Engineering Corporation), the Respondent now tries to supply some other support for a finding of title in the Respondent. This is done in the Opposition Brief by a scattering of other items, such as:

(a) The self-serving statement of the Respondent in her Affidavit of July 3, 1974 (Appendix L to Respondent's Opposition Brief) that "she is *not aware* of any person heretofore or at present claiming any title to the patent in suit".

(b) The self-serving statement of the Respondent in her deposition of September 26, 1974 wherein she answered the question "who is the present owner of Patent No. 3,174,863" with the response "I am".

(c) The testimony of Robert C. Read, a friend of the Respondent, at the hearing on title, when asked

if *he* knew of anyone else who had an interest in the patent, responded "No, I *know* of no one".

(d) The testimony of Berwyn B. Braden, also a friend of the Respondent, who when also asked if *he* knew of anyone else claiming to have any title in the patent, responded "I *know* of no one".

(In respect to the testimony of Mr. Read and Mr. Braden, the District Court refused to permit questioning of the Respondent as to the identity of those having an interest or share in the proceeds of the action.)

(e) The testimony of the same Robert C. Read who attempted to explain away in the purported Assignment of October 25, 1963 (Appendix H to the Petition) to the Irene Schneider Trust from Shoup Engineering Corporation, the there stated exemption of *"except for a previous assignment for Five Thousand ($5,000.00) Dollars"*. This "explanation" consisted of his opinion that the stated exemption was false by his remark "There was no actual assignment". When Mr. Read was asked if he knew this of his own knowledge, he offered the unsupported hearsay statement of "Yes, *I know Mr. Shoup told me that,* yes."

None of the above items proffered by Respondent as "evidence" of title to the patent are *legal evidence* of title. Title is not to be determined by popularity polls, or by the number of persons who say they do not personally know of anybody else who owns the patent, or by the self-serving statement of a plaintiff contending that she is the owner.

Congress has provided by 35 USC 261 that title can be transferred from the named inventor (and originally the owner) *only* by written assignment instruments. The

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only written assignment from *a party holding title*, and hence legally able to transfer title, is the Assignment of January 21, 1965 (Appendix I to the Petition) from Allen A. Shoup to the Shoup Engineering Corporation, present holder of title. On October 25, 1963, when Shoup Engineering Corporation purported to assign title (with the exemption of a previous assignment) to the Irene Schneider Trust by means of the "Assignment" (Appendix H to Petition), the Shoup Engineering Corporation *possessed no title*, and admittedly did not possess full title to transfer.

Therefore, the only legal evidence on the subject of title and which is to govern under the requirements of the statute, is the Assignment of January 21, 1965 to Shoup Engineering Corporation. The above items of "testimony" and expressions of opinion offered by Respondent to refute this legal evidence cannot prevail.

3. The March 14, 1961 Subscription Agreement Transferred No Title to the Then Non-Existing Shoup Engineering Corporation.

The unauthenticated Subscription Agreement of March 14, 1961 (Appendix G to Petition) by which Allen A. Shoup agreed to assign in the future certain vaguely described rights in a broiler to the Shoup Engineering Corporation, yet to be formed and not then in legal existence, was not a written assignment instrument as required by 35 USC 261. To be considered in connection with this unauthenticated paper are the following:

(a) The paper was never considered to be an assignment in that it was never presented for recording in the Patent Office under the provisions of 35 USC 261, and hence was not recorded.

(b) The execution of the paper was never considered to be an assignment, in that its execution was

not acknowledged before an appropriate officer, such as a notary public, in accordance with the provisions of 35 USC 261 covering assignments.

(c) Allen A. Shoup, the inventor who signed the Subscription Agreement, did not consider this paper to be an assignment or otherwise he would not needlessly have gone through the act of signing the later actual Assignment of January 21, 1965 (Appendix I to Petition) from himself to Shoup Engineering Corporation at a time when it was in legal existence.

(d) The Shoup Engineering Corporation was not in legal existence on March 14, 1961 when Mr. Shoup signed the Subscription Agreement (Appendix G to the Petition). According to the Certificate of the Wisconsin Secretary of State (of which a reproduction appears as Appendix M to Respondent's Opposition Brief), the Shoup Engineering Corporation was not granted by the State of Wisconsin "the powers and privileges conferred by the Wisconsin Statutes" on corporations until April 12, 1961. Hence, Shoup Engineering Corporation was not chartered as a corporation until April 12, 1961, *a month after* the March 14, 1961 Subscription Agreement.

Therefore, no legal title to the Shoup patent passed through the Subscription Agreement of March 14, 1961, and Respondent possesses no title in reliance upon that paper called the Subscription Agreement.

4. The Digest Maintained by the Patent Office of Assignment Papers Received for Recording Has No Probative Value Whatever on the Issue of Title.

The Respondent refers to a Patent Office Digest (copy appearing as Appendix K attached to Respondent's Brief)

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as though it were evidence of title. The Patent Office maintains as a convenience to the public, but not as a statutory or official duty, a Digest of the Assignments that have been received for recording. One searching for a determination of title looks to this Digest as a *guide* in finding the actual Assignment instruments that have been recorded. However, it is the contents of the Assignment instruments themselves which determine title. It is not the clerk maintaining the Digest who adjudges who is the holder of title.

It was a clerk not shown to be competent, and certainly not having the lawful authority to adjudge the matter, who mistakenly noted in the Digest the Assignment of January 21, 1965 (Appendix I to the Petition) as having assigned the patent "as of Mar. 14, 1961", *a legal impossibility*. A clerk keeping the unofficial Digest, without apparently understanding the content or import of the papers received, also mistakenly noted in the Digest that by the Assignment of October 25, 1963 (Appendix H to the Petition), Allen A. Shoup assigned "the entire interest in said patent" to the Irene Schneider Trust, *another legal impossibility*.

The clerks making the entries in the unofficial Digest totally failed to note and consider:

(a) That on October 25, 1963, the Shoup Engineering Corporation possessed no title whatever and therefore that purported "Assignment" of October 25, 1963 to the Irene Schneider Trust was a nullity.

(b) That on January 21, 1965, Allen A. Shoup *then* possessing full title as inventor assigned the patent to the Shoup Engineering Corporation (the present holder of title according to the record).

(c) That in the *purported* "Assignment" of October 25, 1963 from the Shoup Engineering Corporation

to the Irene Schneider Trust, there was a stated exemption of *"a previous assignment for Five Thousand ($5,000.00) Dollars"* in the conveyance to the Irene Schneider Trust which was thereby put on notice of the exemption. Thus, even *if* any title was so conveyed to the Irene Schneider Trust (but *none* was conveyed), it was legally impossible for the "*entire* interest" to be conveyed to the Irene Schneider Trust. Of course, if the Irene Schneider Trust did not receive 100% title, the Respondent could not have possessed 100% title which is a prerequisite for a right to sue for infringement of the patent.

The *only* value of the Digest (Appendix K to the Respondent's Brief In Opposition) is that it might be an explanation of why the Patent Office clerks, of unknown competence, were so confused as to lead them to make such *grossly* erroneous and misleading entries in the Digest. *Both* the Assignment of October 25, 1963 *from* the Shoup Engineering Corporation to the Irene Schneider Trust, and the Assignment of January 21, 1965 from Allen A. Shoup *to* the Shoup Engineering Corporation, were received for recording, and were recorded, on January 22, 1965, as shown on the Digest.

Apparently, the erroneous and misleading entries made in the unofficial Digest were referred to, and depended upon, by the Patent Office clerks directing the printing on the head of the patent of the false statement that at the time of issuance the Irene Schneider Trust was the owner.

With mistake based on mistake, the accumulated errors ended in a false notation as to title appearing on the face of the patent, a notation upon which the Courts below both based their ruling on title. Thus, rather than there being a judicial determination of title based on the actual contents

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of the written assignment instruments of record, the judgment below on the issue of title was actually made by some unknown persons in the Patent Office not having the legal authority, or shown to have the legal competence, to make such a determination.

5. There Is No Basis for a Ruling of Title Being in the Respondent Based on Alleged Recognition of Title in the Respondent by Other Manufacturers.

In a strained effort to bolster up the finding of title being in the Respondent, the Respondent's Opposition Brief, at page 4, refers to licenses under the patent for the "Toastmaster broiler", the "Farberware broiler", and the "Cory broiler", as evidence of recognition by others of Respondent's title.

However, there was no evidence in the record of a license on the Farberware broiler, the Respondent's counsel at trial refusing to produce such a supposed license. Also at the trial of the case, there was no evidence of a then existing license on the Toastmaster broiler. In addition, there was no evidence of any Cory broiler having ever been made under a license. Moreover, if others "bought their peace" and succumbed by accepting a license on the basis of representation by the licensor of having title, such acquiescence, if any, is not determination at all on the issue of title.

The presentation now by Respondent of some meager measure of "recognition" of title being in Respondent, only emphasizes the dependence of the Respondent on some peripheral factors as purported "recognition" by others, and also emphasizes the marked reluctance to depend upon the written assignment instruments as evidence of title.

6. The Old Decisions Cited on Page 8 of Respondent's Opposition Brief in No Manner Support the Respondent's Contention That the Recorded Written Assignment Instruments May Be Ignored in Determining Title.

According to the provision of 35 USC 152, "Patents may be granted to *the assignee* of the inventor of record in the Patent Office * * *." Inasmuch as the *legal assignee* of the Shoup patent, according to the Assignment of January 21, 1965 (Appendix I to the Petition) recorded January 22, 1965 shortly before the patent issued, is the Shoup Engineering Corporation, according to the dictates of 35 USC 152, the patent *should* have been granted to Shoup Engineering Corporation.

Inasmuch as the Irene Schneider Trust was *not* the *legal assignee*, as heretofore demonstrated by Petitioner, the Irene Schneider Trust was a *stranger* to title and the patent erroneously was "granted" to the Irene Schneider Trust.

The old decisions cited on page 8 of the Respondent's Opposition Brief merely bear out the same point as now expressly set forth in 35 USC 152. That point is that if there are proper written assignment instruments recorded before a patent is issued, the patent is to be issued, not to the named inventor, but rather to *the legal assignee as evidenced* by the proper written assignment instruments of record.

Following the same principle as expressly stated in the statute, the old decisions cited by Respondent merely recognize as the owner of the patent the party to whom it was granted pursuant to the contents of written assignment instruments recorded before the grant of the patent.

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For example, the cited 1850 decision of *Gayler v. Wilder*, 51 U.S. (10 How.) 477 affirms that a patent is to be granted to the true legal assignee whose assignment instrument is recorded before issuance and is to be recognized as the owner of the patent. This decision held that a party to whom a proper assignment was made and recorded in the Patent Office before the patent issues is to be recognized as owner for purposes of a patent infringement action rather than the assignor to whom the patent document was mistakenly issued and sent by the Patent Office personnel.

This is fully in accord with the Petitioner's contention that the Shoup patent is owned fully by Shoup Engineering Corporation.

The other decisions cited by Respondent only confirm that which the Petitioner has been contending. This contention is that the true owner is the party whose ownership is evidenced by proper written assignment instruments, and the patent legally should issue to the one so designated by proper written assignment instruments that have been recorded before the issuance of the patent.

Under the law as found in the decisions cited by Respondent, and under the law as expressly set forth in the statutes:

(a) Title to the patent did *not* reside in the Irene Schneider Trust when the patent issued (nor at any time) and hence the patent should not have issued to the Irene Schneider Trust;

(b) Title to the patent in suit resided in the Shoup Engineering Corporation when the patent issued, and title still resides in the Shoup Engineering Corporation;

(c) The Irene Schneider Trust, not having any title to the patent, could not legally assign it to Respondent and any purported assignment to Respondent was a nullity.

(d) Respondent, being a stranger to title, had no capacity to institute and maintain this action.

CONCLUSION

Other than repeating in Respondent's Opposition Brief the remark that Petitioner "is incorrect", the Respondent has totally failed to justify the judgments of the Courts below.

Petitioner requests that its right to be sued only by the legal owner of the patent and not to be left vulnerable to a later suit by the legal owner, be protected and not be denied on the basis of the cumulative errors of the Courts below in applying the controlling law.

Petitioner requests that the principle, heretofore enunciated in the decision of this Court and of the Second Circuit Court of Appeals, that the issue of title to copyrights be determined by the Courts rather than by agency personnel, be applied here to the issue of title to patents.

Rights and liabilities under patents should be clarified by this Supreme Court upon review of the judgments below.

Respectfully submitted,

BRUCE B. KROST
WOODLING, KROST, GRANGER & RUST

DALLETT HOOPES

CLARENCE J. FLEMING
MCDOUGALL, HERSH & SCOTT

Attorneys for Marshall Field & Co., Petitioner

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Supreme Court of the United States

October Term, 1975
No. 75-1405

MARSHALL FIELD & CO.,
Petitioner,
vs.
MARIAN SHOUP,
Respondent.

PETITION FOR REHEARING

To The Honorable, the Chief Justice and the Associate Justices of the Supreme Court of the United States:

Your Petitioner, Marshall Field & Co., respectfully prays for reconsideration under the provisions of Rule 58, Paragraph 2, of the Supreme Court Rules, of the denial on May 19, 1976 of the Petition For Writ Of Certiorari.

The grounds for this Petition For Rehearing were available to Petitioner at the time of filing the Petition For Writ Of Certiorari, but were not presented therein.

The grounds set forth in the Petition For Writ Of Certiorari were the Respondent's lack of title to the patent in suit as determined by the controlling statutes and hence the Respondent's lack of capacity to sue for infringement of the patent. It was there demonstrated that title to the patent resides in a third party, Shoup Engineering Corporation, and Petitioner remains vulnerable to an action for infringement by the true owner of the patent.

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Because the right of a party to be sued for patent infringement only by the owner of the patent is so fundamental and well established, it was difficult to cite a conflicting decision in other circuits on this precise issue of title to a patent. However, the Petition For Writ Of Certiorari cited prior decisions regarding the issue of title to copyrights rendered by this Court and by the Second Circuit Court of Appeals which are in conflict with the decision below.

Although there were other erroneous holdings of the Court below directed to the issue and validity of the patent which could have been presented by the Petitioner, this was not done because the issue of title appeared to be clear-cut and the error of the ruling on title seemed to be manifest.

Petitioner now requests this Court to consider the matter that the patent in suit is *invalid on its face* and without the need for considering any evidence such as the prior art patents showing the same structure and arrangement. The reason the patent in suit is invalid on its face is that it clearly does not meet the mandate of 35 U.S.C. 112 which sets forth the legal requirements for obtaining a patent monopoly.

The second paragraph of Section 112 of Title 35, United States Code (the patent statutes), reads:

> "The specification shall conclude with *one or more claims particularly pointing out and distinctly claiming* the subject matter which the applicant regards as his invention. A claim may be written in independent or dependent form, and if in dependent form, it shall be construed to include all the limitations of the claim incorporated by reference into the dependent claim."

The Shoup patent in suit No. 3,174,863 is before the Court as Appendix F in the Additional Appendix To Petition For Writ Of Certiorari.

The patent is directed to a broiler having in a housing or rectangular box three principal parts:

(a) A food supporting grill above upon whatever food to be cooked is placed;

(b) A heating element (a zig-zag electric resistance wire) positioned below the food supporting grill; and

(c) A pan or surface below the heating element and into which grease from the food being cooked (if it is a fat-containing food) drops and collects.

The claims of the patent are directed to a *first* spacing between (a) the food supporting grill and the heating element and a *second* spacing between the heating element and the grease collecting pan or surface below. The invention is purportedly directed to the idea of having these two spaces of such dimensions that the grease does not become overheated and hence does not flame and smoke.

This critical "spacing", upon which the patent depends, is defined in the claims in such an indefinite, vague, and meaningless way that *no one* can determine what this spacing must be in order to come within the patent monopoly, *or* to avoid or escape the patent monopoly.

Claim 1 of the patent "defines" the first space (between the food supporting grill and the heating element) by the words "means for supporting said grill A DISTANCE ABOVE said heating element SO THAT the

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temperature of the grill as heated by the heating element is below the smoke and flame temperature range" (that is, no flaming and smoking).

Claim 1 "defines" the second space (between the heating element and the grease pan below) by the words "said heating element being SPACED A SUFFICIENT DISTANCE ABOVE a surface on to which the fats fall SO THAT said surface as heated by the heating element operates below the smoke and flame temperature range" (that is, no flaming and smoking).

Claim 2 similarly "defines" this same first distance by the words "SPACING said grill a SUFFICIENT DISTANCE above the heating element" to avoid flaming and smoking, and "defines" this same second distance by the words "SPACING said heating element A SUFFICIENT DISTANCE ABOVE a lower surface on to which said fats fall SO THAT" flaming and smoking is avoided.

Claim 3 similarly "defines" this first distance by the words "supporting the grill A DISTANCE ABOVE said heating element SO THAT" flaming and smoking is avoided, and "defines" this second distance by the words "a fat collecting pan spaced A SUFFICIENT DISTANCE BELOW said heating element SO THAT" flaming and smoking is avoided.

Claim 4 similarly "defines" this first distance by the words "supporting said grill A DISTANCE ABOVE said heating element SO THAT" flaming and smoking is avoided, and "defines" this second distance by the words "said heating element being SPACED A SUFFICIENT DISTANCE above a surface on to which the fats fall SO THAT" flaming and smoking is avoided.

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Claim 5 similarly "defines" this first distance by the words "means for supporting said grill A DISTANCE ABOVE said heating element SO THAT" flaming and smoking is avoided, and "defines" this second distance by the words "said heating element being SPACED A SUFFICIENT DISTANCE ABOVE a surface on to which the fats fall SO THAT" flaming and smoking is avoided.

Claim 6 similarly "defines" this first distance by the words "supporting said grill A DISTANCE ABOVE said heating element SO THAT" flaming and smoking is avoided, and "defines" this second distance by the words "said heating element being SPACED SUFFICIENTLY ABOVE a surface on to which the fats fall SO THAT" flaming and smoking is avoided.

NO ONE can determine from *inspection or measuring* of a physical broiler whether or not that broiler has its three parts spaced apart such distances that it comes *within* the patent monopoly and hence infringes, or is outside of the patent monopoly and hence does not infringe.

The many, many factors which determine whether or not flaming and smoking occurs in a broiler, include among others:

(1) The then prevailing room temperature,

(2) The residual heat which might be in the broiler from preheating or from prior broiling,

(3) The temperature to which the heating element happens to be set by the operator,

(4) Whether the food being cooked contains any fat (bread being toasted or bacon being broiled),

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(5) The relative amount of fat in meat being cooked (lean meat or very fat meat),

(6) The kind of meat (pork, beef, chicken, or lamb), the fat in each having a different kindling point when flame and smoke is produced, and

(7) The amount of fat allowed to collect in the grease pan before being emptied, and hence subjected to heat.

(8) The time period during which the collected grease is subjected to the heat.

A manufacturer of broilers cannot determine *from the patent claims* whether or not a broiler being manufactured comes within the patent monopoly.

A retail store, such as Petitioner, cannot determine *from the patent claims* whether or not a broiler being retailed comes within the patent monopoly.

A housewife using a broiler, such as a customer of the Respondent, cannot determine whether or not a broiler she is using comes within the patent monopoly.

None of these classes of potential infringers, manufacturer, seller, and user, has any way in order to determine from the patent whether or not a certain broiler infringes.

A Court, likewise, has no way whatever to properly determine from the patent whether or not a certain accused broiler is an infringing broiler.

The *critical importance* to the public of 35 U.S.C. 112 requiring that a valid patent must have *"claims particularly pointing out and distinctly claiming"* the invention, is to be recognized. Without this essential safeguard provided by 35 U.S.C. 112, the public is left in a most dangerous and perilous position.

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Another way of expressing the requirements of this statute is to state that a patent must contain claims which provide adequate "no trespassing signs". Without such adequate "no trespassing signs", trespassing may not be avoidable, and an innocent member of the public may be entrapped as an infringer.

The lower courts have generally recognized the critical need of distinct, definite claims for defining the boundaries of a patent monopoly. This need for such distinctly marked boundaries for protecting the public interest was aptly phrased in a decision of the District Court for Maryland, in which it stated:

> "*The claims should point out the limits* of the patent. Where they do not, they fail in their purpose of describing the *boundaries* of the invention, within which no one may properly operate unless licensed under the patent; outside of which the field is open to the public. *Where such 'no trespassing' signs are not properly posted defining* the protected boundaries, the claims are invalid."
>
> *Marshall v. Procter & Gamble Mfg. Co.*, 210 F. Supp. 619; 135 U.S.P.Q. 239 (D.Ct., Md., 1962)

If one were looking for a *prime example* of a patent wrongfully issued by the Patent Office because it does not include reasonable and definite "no trespassing signs", this Shoup patent would be that patent.

Of course, there could be no suggestion of an invention in a "discovery" that grease or greasy food will flame and smoke if it is subjected to too much heat for too long. It is ancient knowledge possessed by every housewife and every camper who cooks that if one holds greasy food or grease *too close* to the heat for *very long*, flaming and smoking will occur. Since this

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phenomenon is ancient knowledge, any "invention" must reside in structure.

The Shoup patent claims are not "particularly pointing out and distinctly claiming" the invention, and hence does not in any degree meet the requirements of 35 U.S.C. 112 set up by Congress to protect the public.

Wherefore, Shoup patent No. 3,174,863 (Appendix F in Additional Appendix To Petition For Writ Of Certiorari) is *invalid on its face.*

Relief is in order when Petitioner has been held liable for trespassing on property not owned by the Respondent and the boundaries of the property are not known or marked. The patent in suit is owned by another and the patent monopoly is not defined with distinct or fixed boundaries by the claims, all contrary to the express statutory conditions for obtaining a valid patent.

The public should not be subjected to such actions by non-owners of such an undefined and nebulous patent monopoly.

If the decision below represents the law of patents, then how can an attorney intelligently advise a client who is confronted with a demand for payment from one not owning a patent and which patent has no defined limits of its monopoly?

In view of the most favorable attitude toward patents by the Court of Appeals of the Seventh Circuit as compared with other Circuits, it is extremely unlikely that the Shoup patent, with all its frailties, will ever be put to a test in any other Circuits. Hence, a con-

flict between Circuits involving this particular patent is most improbable. Only a sharp conflict of principles of law is here present.

Reconsideration is believed to be deserved. Hence, the Petitioner requests that this Petition For Rehearing be granted, and that review be ordered.

Respectfully submitted,

BRUCE B. KROST
WOODLING, KROST, GRANGER & RUST

DALLETT HOOPES

CLARENCE J. FLEMING
McDOUGALL, HERSH & SCOTT
Attorneys for Marshall Field & Co., Petitioner

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